In the Supreme Court of the United States.

EX PARTE THE NATIONAL ENAMELING AND STAMPING COMPANY AND THE LALANCE & GROSJEAN MANUFACTURING COMPANY.

The above named petitioners, National Enameling and Stamping Company and the Lalance & Grosjean Manufacturing Company, upon the petition hereto annexed and the exhibits made a part thereof, now move the Honorable, the Justices of the Supreme Court of the United States for a rule on the Judges of the United States Circuit Court of Appeals for the Second Circuit, to show cause at the earliest practicable day that can be designated under the practice of this Court, why a writ of mandamus should not be issued, commanding them to reinstate and take jurisdiction of the cross-appeal of said petitioners, dated August 8, 1905, from the decree entered on the 8th day of July, 1905, in the suit in equity in the Circuit Court of the United States for the Southern District of New York, in which said petitioners are complainants, and the New England Enameling Company is defendant, and commanding said Judges thereafter to make such disposition of said cross-appeal as ought to have been made had the same not been dismissed by them "for the want of jurisdiction," and why the petitioners should not have such other and further relief in the premises as may be proper.

Dated New York, N. Y., January 5th, 1906.

ARTHUR V. BRIESEN,
LOUIS MARSHALL,
WALTER D. EDMONDS,
Of Counsel for Petitioners.

4 TO THE HONORABLE, THE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

The joint petition of The National Enameling and Stamping Company and the Lalance & Grosjean Manufacturing Company, respectfully shows:

1. Your petitioner, The National Enameling and Stamping Company is a corporation duly incorporated and doing business under and pursuant to the laws of the State of New Jersey, and your petitioner, Lalance & Grosjean Manufacturing Company, is a corporation duly organized and
5 doing business under and pursuant to the laws of the State of New York.

2. On or about the 18th day of March, 1903, a suit in equity was duly commenced by your petitioners, as complainants, in the Circuit Court of the United States for the Southern District of New York, against the New England Enameling Company, a corporation duly organized and doing business under and pursuant to the laws of the State of Connecticut, and having a regular and established place of business within said Southern District of New York, to restrain the infringement by that Company of Letters Patent of the United States, No. 527,361, granted to Hubert Claus, October 9,
6 1894, for improvements in enameling metal ware, and to recover damages and profits for such infringement, and for the other relief usual in such cases. A copy of the specification of said Letters Patent is hereto annexed and marked Exhibit "A."

3. Thereafter issue was duly joined in said cause and exceptionally voluminous proofs taken therein at great expense on behalf of both parties, the printed record on said appeal comprising 3,093 pages. The said cause, upon said pleadings and proofs, came on for final hearing by said Court, which, on

the 8th day of July, 1905, entered its decree therein, 7
in and by which said decree, the 4th, 5th, 6th, 7th and 8th claims of said patent were adjudged to be valid and infringed by said defendants, the 9th, 10th, 11th and 12th claims valid but not infringed, and the 1st, 2d and 3d claims invalid, and the bill dismissed as to said claims 1, 2, 3, 9, 10, 11 and 12.

4. On or about the first day of August, 1905, the said defendant appealed from said decree to the said Circuit Court of Appeals. True copies of the said appeal, assignment of errors thereon, and citation are hereto annexed and marked respectively Exhibits B, C and D; said appeal has not yet been heard, but has been set for argument at the Febru- 8
ary, 1906, session.

5. On the 8th day of August, 1905, your petitioners, on their part, appealed from the decree dismissing the bill. True copies of their said cross appeal (E), assignment of errors (F), and citation (G), are likewise hereto attached and marked respectively Exhibits E, F and G.

6. The said New England Enameling Company moved the said Circuit Court of Appeals to dismiss your petitioners' said cross appeal, because of its alleged want of jurisdiction thereover. True copies of the notice of said motion (H), and of the motion 9
(I), are hereto annexed and marked Exhibits H and I; also true copies of all the other papers on which said motion was based, being as follows, viz.: the affidavit of John O. Gempler (J), verified October 9, 1905, the citation on your petitioners' said cross appeal (G), your petitioners' said cross appeal (E), your petitioners' assignments of errors (F), and the said decree (K), which said papers so annexed are respectively marked Exhibits J, G, E, F and K; also of the Clerks' certificates filed on behalf of your petitioners, copies of which are annexed and marked Exhibit L (pp. 27 and 28 hereof).

7. Thereafter the said motion came on to be heard
10 by said Circuit Court of Appeals, and was duly argued by both parties on the 16th day of October, 1905, and the said Court thereafter granted the said motion, and refused to entertain, and dismissed your petitioners' said cross-appeal on the ground that said Court had no jurisdiction thereover, as is shown by the order entered in said cause on the 3d day of January, 1906, a true copy of which is hereto annexed and marked Exhibit M. With the knowledge and consent of the said New England Enameling Company, your petitioners have paid one-half of the Clerk's fees for certifying, preparing and printing the record on said appeals, amounting in the aggre-
11 gate to the sum of $1,819.20.

8. Your petitioners are advised and believe that said order of January 3, 1906, dismissing your petitioners' said cross-appeal, on the ground that the Court did not have jurisdiction to entertain said appeal, was improperly made; but that on the contrary the said Circuit Court of Appeals had, and has jurisdiction and power to entertain and dispose not only of said New England Enameling Company's appeal, but also simultaneously of your petitioners' said cross-appeal, and of the entire cause upon the merits, and that your petitioners have no other relief in the premises except by mandamus from this Honorable
12 Court.

9. Your petitioners are now advised and believe that said decree, in so far as it dismissed your petitioners' bill of complaint, was a final decision, and adjudicated as completely and finally as could be done by the Circuit Court of the United States; that claims 1, 2 and 3 of said patent are invalid, and that claims 9, 10, 11 and 12 are not infringed by said New England Enameling Company; that by the said dismissal of their said cross-appeal your petitioners have been prevented from reversing said final decision by an appeal taken as required within the six months limited by law; that said

New England Enameling Company, by exercising 13
the option accorded them by the Act of Congress of June 6, 1900, by taking their appeal at this stage of the cause, did thereby open the entire cause and decision of the Circuit Court to review, and conferred on said Circuit Court of Appeals jurisdiction to so review on the merits, and that therefore your petitioners' said cross-appeal was properly taken and was improperly dismissed.

10. Unless the said mandamus is granted, your petitioners will either be precluded from reversing the decree of the United States Circuit Court which adjudged the 1st, 2d and 3d claims of their Letters Patent invalid, and the 9th, 10th, 11th and 12th 14
claims thereof not infringed, or the entire record of said cause will necessarily be twice separately before said Court of Appeals on two separate appeals relating to the questions of validity and infringement of said claims of said patent, and thereby the burdens of the Court and of the parties unnecessarily and improperly doubled, thus bringing the case up for review piecemeal, and possibly, in each instance, before a differently constituted Court, to the irreparable injury, jeopardy and delay of your petitioners.

11. It is of the utmost importance to all of the parties to said cause that there shall be the speediest possible adjudication by the United States Circuit 15
Court of Appeals as to the validity of all of the claims of the aforesaid Letters Patent which are the subject matter thereof, and that it is especially important to your petitioners that their rights thereunder shall be finally and authoritatively adjudicated without delay, owing to the fact that said Letters Patent will expire on the 9th day of October, 1911.

WHEREFORE, your petitioners pray that this Honorable Court will issue a writ of mandamus, commanding the Judges of the United States Circuit Court of Appeals for the Second Circuit to take jurisdiction over and to reinstate your petitioners'

16 said cross-appeal and to make such disposition thereof, simultaneously with said appeal of said New England Enameling Company, as ought to have been made had the same not been dismissed, and the said order of January 3d, 1906, entered.

And your petitioners further pray that pending this honorable Court's final determination of this, their petition, all proceedings in said cause, and on said appeal of said New England Enameling Company, may be stayed, and also that there be granted to your petitioners such other and further relief, or both, in the premises as may be just.

And your petitioners will ever pray, &c.

17

Dated this 5th day of January, 1906.

NATIONAL ENAMELING AND STAMPING CO.,
By A. M. STEINHARDT,
Treasurer.

LALANCE & GROSJEAN MFG. CO.,
By JAS. COCHRAN,
Vice-President.

UNITED STATES OF AMERICA, }
State and County of New York, } ss.:

On this 5th day of January, 1906, personally came before me Adolph M. Steinhardt, Treasurer
18 of the National Enameling and Stamping Company, one of the petitioners named in the foregoing petition, who, being by me duly sworn, deposes and says: That he is the Treasurer of the said Company; that he has read the foregoing petition subscribed with the name of said Company per himself as Treasurer; that he knows the contents thereof; that the same is true of his own knowledge, except as to those matters therein stated to be alleged on information and belief, and as to those matters he believes it to be true.

PHILIP C. PECK,
[L. S.] Notary Public,
New York County.

UNITED STATES OF AMERICA, State and County of New York, } ss.:

On this 5th day of January, 1906, personally came before me James Cochran, Vice-President of the Lalance & Grosjean Manufacturing Company, one of the petitioners named in the foregoing petition, who, being by me duly sworn, deposes and says: That he is the Vice-President of the said company; that he has read the foregoing petition subscribed with the name of said company per himself as Vice-President; that he knows the contents thereof; that the same is true of his own knowledge, except as to those matters therein stated to be alleged on information and belief, and as to those matters he believes it to be true.

PHILIP C. PECK,
Notary Public,
New York County.

[L. S.]

22 **Exhibit B.**

UNITED STATES CIRCUIT COURT,

SOUTHERN DISTRICT OF NEW YORK.

In Equity.

NATIONAL ENAMELING AND STAMPING COMPANY and LALANCE & GROSJEAN MANUFACTURING COMPANY,
23 Complainants,

vs.

NEW ENGLAND ENAMELING CO.,
Defendant.

Petition for Appeal.

The New England Enameling Company, defendant in the above entitled cause, feeling itself aggrieved by the decree against it in this cause and
24 entered at a Stated Term of the United States Circuit Court, held in and for the Southern District of New York, at the Borough of Manhattan, State of New York and City of New York, on the 8th day of July, 1905, does hereby appeal from the said order to the United States Circuit Court of Appeals for the Second Circuit, for reasons specified in the assignment of errors, which is filed herewith, and prays that its appeal may be allowed, and a citation directed to the above named complainants, National

Enameling and Stamping Company and Lalance & Grosjean Manufacturing Company, commanding them to appear before the United States Circuit Court of Appeals for the Second Judicial Circuit, to do and to receive what may appertain to justice to be done in the premises, and that a transcript of the record, proceedings and papers in said cause upon which said decree was made, duly authenticated, may be sent to the United States Circuit Court of Appeals for the Second Judicial Circuit. 25

STEINHARDT & GOLDMAN,
Solicitors for Defendant-Appellant.

WM. HOUSTON KENYON,
ROB'T. N. KENYON,
WALTER F. ROGERS, 26
Of Counsel.

Appeal allowed this 1st day of August 1, 1905.

E. H. LACOMBE,
U. S. Circuit Judge.

27

28 **Exhibit C.**

UNITED STATES CIRCUIT COURT,

SOUTHERN DISTRICT OF NEW YORK.

In Equity.

NATIONAL ENAMELING AND STAMPING COMPANY and LALANCE & GROSJEAN MANUFACTURING COMPANY,
29 Complainants,

vs.

NEW ENGLAND ENAMELING COMPANY,
Defendant.

And now comes the defendant-appellant in the above entitled cause, and says that in the record and proceedings therein there is manifest error in this, to wit:

30 FIRST.—That the Circuit Court of the United States for the Southern District of New York erred in finding that the defendant had infringed Claims 4, 5, 6, 7 and 8 of Letters Patent No. 527,361.

SECOND.—That the Circuit Court of the United States for the Southern District of New York erred in not finding that the defendant had not infringed Claims 4, 5, 6, 7 and 8 of said Letters Patent No. 527,361.

THIRD.—That the Circuit Court of the United States for the Southern District of New York erred

in not finding that Letters Patent No. 527,361, so far 31
as Claims 4, 5, 6, 7 and 8 are concerned, are invalid and void:

(*a.*) As being anticipated by the prior art disclosed by the record;

(*b.*) as being devoid of patentable invention in view of the prior art disclosed by the record;

(*c.*) as being for a different invention from that set out in the specification;

(*d.*) as being for a different invention from that held by the Court to be the real invention disclosed 32
by said Patent No. 527,361 over the art;

(*e.*) as being for an invention insufficiently and improperly and not legally described in the said patent;

(*f.*) as being for an invention not properly or legally claimed in said claims.

FOURTH.—That the Circuit Court of the United States for the Southern District of New York erred in finding that Claims 4, 5, 6, 7 and 8, or any of them, of said Letters Patent No. 527,361 are valid.

FIFTH.—That the Circuit Court of the United 33
States for the Southern District of New York erred in interpreting Claims 4, 5, 6, 7 and 8 as product claims while distinguishing them from the art only by the process by which the product is made.

SIXTH.—That the Circuit Court of the United States for the Southern District of New York erred in sustaining the product Claims 4, 5, 6, 7 and 8 as valid while distinguishing the invention from the art only by steps in the process which do not persist in the product.

34 SEVENTH.—That the Circuit Court of the United States for the Southern District of New York erred in holding Claims 4, 5, 6, 7 and 8 valid by construing the distinguishing characteristics recited in said claims as applying to a certain early step or condition in the process of manufacture, to wit, the so-called "mix," whereas those distinguishing characteristics are clearly and unequivocally recited in the claims as applying to the coating or enamel upon the finished article, to wit, the so-called "frit" or "dip" actually applied to the article and with which alone the "metallic oxides" are combined.

EIGHTH.—That the Circuit Court of the United
35 States for the Southern District of New York erred in not holding that Claims 4, 5, 6, 7 and 8 are invalid and void, because the characteristics of the coating or enamel upon the finished article recited in said claims were not novel with Claus nor the combination of such coating or enamel with metallic oxides as recited in said claims.

NINTH.—That the Circuit Court of the United States for the Southern District of New York erred in interpreting Claims 4, 5, 6, 7 and 8 of the Letters Patent No. 527,361 in terms not found in the patent.

36 TENTH.—That the Circuit Court of the United States for the Southern District of New York erred in ordering an injunction and accounting upon Claims 4, 5, 6, 7 and 8 of Letters Patent No. 527,361.

ELEVENTH.—That the Circuit Court of the United States for the Southern District of New York erred in not dismissing the bill of complaint, with costs to the defendant.

Wherefore, the said New England Enameling Company prays that the decree of the Circuit Court of the United States for the Southern District of

New York be reversed, and that the Circuit Court 37
of the United States for the Southern District of New York be directed to enter a decree dismissing the bill of complaint, with costs to the defendant.

STEINHARDT & GOLDMAN,
Solicitors for Defendant-Appellant.

WM. HOUSTON KENYON,
ROBT. N. KENYON,
WALTER F. ROGERS,
Of Counsel.

(Endorsed)—U. S. Circuit Court, Southern Dist. of New York.—National Enameling & Stamping Co. *et al. vs.* New England Enameling Co., Deft.—Assignment of Errors. 38

Exhibit D.

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE SECOND CIRCUIT.

PRESIDENT OF THE UNITED STATES TO NATIONAL ENAMELING AND STAMPING CO. AND LALANCE & GROSJEAN MANUFACTURING COMPANY, GREETING:

39

You are hereby cited and admonished to be and appear at the session of the United States Circuit Court of Appeals for the Second Circuit, to be held at the City of New York, in the State of New York, in said circuit, on the 29th day of August, 1905, pursuant to an appeal duly obtained from a decree of the United States Circuit Court for the Second District of New York, entered in the office of the Clerk of said Court, on the 8th day of July, 1905, wherein the New England Enameling Company is the appellants, and you are the appellees, to show cause, if any there be, why said decree entered against the

said appelllant, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness, the Honorable MELVILLE W. FULLER, Chief Justice of the United States, this 1st day of August, in the year of our Lord one thousand nine hundred and five.

E. H. LACOMBE,
United States Circuit Judge.

Exhibit E.

UNITED STATES CIRCUIT COURT

FOR THE SOUTHERN DISTRICT OF NEW YORK.

NATIONAL ENAMELING AND STAMPING COMPANY and LALANCE & GROSJEAN MANUFACTURING COMPANY,
Complainants,

vs.

NEW ENGLAND ENAMELING COMPANY,
Defendant.

Appeal.

The above named complainants, considering themselves aggrieved by the decree of this Court, filed and entered herein on the 8th day of July, 1905, dismissing the Bill of Complaint herein as to claims 1, 2, 3, 9, 10, 11, 12 of Letters Patent No. 527,361, of October 9th, 1894, for enameling metal ware, here in

suit, do hereby appeal to the United States Circuit 43
Court of Appeals for the Second Circuit, and pray that their appeal may be allowed and citation granted, directed to the above named defendant, commanding it to appear before said United States Circuit Court of Appeals to do and receive what may appertain to justice to be done in the premises, and that a transcript of the pleadings and proofs, exhibits, evidence, records and proceedings in this cause, duly authenticated, may be sent to the United States Circuit Court of Appeals for the Second Circuit.

Dated New York, August 8th, 1905.

GUGGENHEIMER, UNTERMYER & MARSHALL,
Solicitors for Complainant, National Enameling 44
and Stamping Co.,
30 Broad Street,
New York, N. Y.

WALTER D. EDMONDS,
Solicitor for Complainant, Lalance & Grosjean
Manufacturing Co.,
31 Nassau Street,
New York, N. Y.

The foregoing appeal allowed.
E. H. LACOMBE,
U. S. Circuit Judge.

45

46 **Exhibit F.**

UNITED STATES CIRCUIT COURT,

FOR THE SOUTHERN DISTRICT OF NEW YORK.

NATIONAL ENAMELING AND STAMPING COMPANY and LALANCE & GROSJEAN MANUFACTURING COMPANY, Complainants, vs. NEW ENGLAND ENAMELING COMPANY, 47 Defendant.	In Equity.

Assignment of Errors.

In pursuance of and obedient to Rule Eleven, formulated and adopted in the United States Circuit Court of Appeals for the Second Circut, the above named complainants respectfully make the following assignment of errors in the above entitled case, to wit:

I.—That the Court erred in holding claim 1 of U. S. Letters Patent No. 527,361 in suit invalid.

48 II.—That the Court erred in holding claim 2 of said Letters Patent invalid.

III.—That the Court erred in holding claim 3 of said Letters Patent invalid.

IV.—That the Court erred in failing to hold claim 1 of said Letters Patent infringed.

V.—That the Court erred in failing to hold claim 2 of said Letters Patent infringed.

VI.—That the Court erred in failing to hold claim 3 of said Letters Patent infringed.

VII.—That the Court erred in holding claim 9 of said Letters Patent not to be infringed. 49

VIII.—That the Court erred in holding claim 10 of said Letters Patent not to be infringed.

IX.—That the Court erred in holding claim 11 of said Letters Patent not to be infringed.

X.—That the Court erred in holding claim 12 of said Letters Patent not to be infringed.

XI.—That the Court erred in failing to award complainants their taxable charges, costs and disbursements of this suit. 50

Wherefore, and for divers other errors in the record of this cause appearing, complainants-appellants pray that the decree entered herein on the 8th day of July, 1905, be reversed as to the above stated claims numbered 1, 2, 3, and as to non-infringement of said claims 9, 10, 11, 12, and that a decree be directed to be entered sustaining the validity of all of said claims and finding infringement of all of said claims by the above named defendant, and awarding an injunction as to all of said claims, and the other relief prayed for in the bill, together with all of the costs and disbursements in the United States Circuit Court and in the United States Circuit Court of Appeals to these 51 complainants-appellants, and for such other and further relief as to the Court may seem meet.

Dated New York, August 8, 1905.

GUGGENHEIMER, UNTERMYER & MARSHALL,
Solicitors for Complainants-Appellants,
National Enameling and Stamping Company.

WALTER D. EDMONDS,
Solicitor for Complainant-Appellant,
Lalance & Grosjean Manufacturing Co.

52 **Exhibit G.**

By the Honorable E. HENRY LACOMBE, Circuit Judge in and for the Southern District of New York, within the Second Circuit, to NEW ENGLAND ENAMELING COMPANY, GREETING:

You are hereby cited and admonished to be and appear before the United States Circuit Court of Appeals for the Second Circuit, to be holden at the Borough of Manhattan, in the City of New York, in the district and Circuit above named, on the 8th day of September, 1905, pursuant to an appeal filed in the Clerk's office of the Circuit Court of the United
53 States for the Southern District of New York, wherein the National Enameling and Stamping Company and Lalance & Grosjean Manufacturing Company are appellants, and you, the said New England Enameling Company are appellee, to show cause, if any there be, why the decree in said appeal mentioned should not be corrected, and speedy justice should not be done in that behalf.

Given under my hand at the Borough of Manhattan, in the City of New York, in the District and Circuit above named, this 8th day of August, in the year of our Lord, one thousand nine hundred and five, and of the Independence of the United States the one hundred and thirtieth.

54 E. H. LACOMBE,
Judge of the Circuit Court of the United States, for the Southern District of New York, in the Second Circuit.

(Filed August 10, 1905.)

Exhibit H.

55

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE SECOND CIRCUIT.

NATIONAL ENAMELING AND STAMPING COMPANY and LALANCE & GROSJEAN MANUFACTURING COMPANY,
Complainants-Cross-Appellants,

vs

NEW ENGLAND ENAMELING COMPANY,
Defendant-Cross-Appellee.

56

Please take notice that on the call of the motion calendar of the United States Circuit Court of Appeals for the Second Circuit on Monday, October 16, 1905, or as soon thereafter as counsel can be heard, we will make a motion to dismiss the cross-appeal taken by the complainants-cross appellants a copy of the motion being annexed hereto. That at the hearing of said motion we will refer to the affidavit of John O. Gempler hereto attached and to the exhibits produced in said affidavit and also attached hereto.

Dated New York, October 9, 1905.

57

Respectfully,

STEINHARDT & GOLDMAN,
Solrs. for Defendant-Cross-Appellee.
ROBERT N. KENYON,
Of Counsel for Defendant-Cross-Appellee.

To GUGGENHEIMER, UNTERMEYER & MARSHALL,
Solrs. for Complt.-Cross-Appellant,
30 Broad Street,
New York; and
WALTER D. EDMONDS, Esq.,
Solr. for Complt.-Cross-Appellant,
31 Nassau Street,
New York.

58

Exhibit I.

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE SECOND CIRCUIT.

NATIONAL ENAMELING AND STAMPING COMPANY and LALANCE & GROSJEAN MANUFACTURING COMPANY,
Complainants-Cross-Appellants,

59 vs.

NEW ENGLAND ENAMELING COMPANY,
Defendant-Cross-Appellee.

And now comes the above named defendant-cross-appellee and shows that on or about July 8, 1905, an interlocutory decree, a true copy of which is hereto attached, was entered herein by the United States Circuit Court for the Southern District of New York, dismissing the bill of complaint as to the first, second, third, ninth, tenth, eleventh and twelfth claims of the patent here in suit, but sus-
60 taining the fourth, fifth, sixth, seventh and eigth claims of said patent, and directing that a permanent injunction be issued restraining the defendant from further infringement of said fourth, fifth, sixth, seventh and eighth claims, and directing that the defendant account for damages and profits for its infringement of said fourth, fifth, sixth, seventh and eighth claims, and referring the cause to a master to ascertain and assess the said profits and damages and to report thereon to the Court; and that thereafter, to wit, on

or about August 1, 1905, the above named defendant took an appeal, which was allowed on the same day, from so much of said decree as granted an injunction under said claims fourth, fifth, sixth, seventh or eighth; and that thereafter, to wit, on or about August 8, 1905, the above named complainants-cross-appellants took an appeal, which was allowed on the same day, from such portions of said decree as dismissed the bill so far as it related to the first, second, third, ninth, tenth, eleventh and twelfth claims of said patent; true copies of the appeal papers of the said complainants-cross-appellants, including the assignment of errors accompanying same, being attached hereto. 61

Wherefore, this defendant-cross-appellee now moves that this Honorable Court dismiss the said appeal of the complainants-cross appellants for want of jurisdiction thereover. 62

Dated New York, October 9, 1905.

STEINHARDT & GOLDMAN,
Solicitors for Defendant Cross-Appellee.

ROBERT N. KENYON,
Of Counsel

63

64

Exhibit J.

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE SECOND CIRCUIT.

NATIONAL ENAMELING AND STAMPING COMPANY and LALANCE & GROSJEAN MANUFACTURING COMPANY,
Complainants-Cross-Appellants,

vs.

65 NEW ENGLAND ENAMELING COMPANY,
Defendant-Cross-Appellee.

STATE OF NEW YORK, }
City and County of New York, } ss.:

JOHN O. GEMPLER, being duly sworn, deposes and says: I am docket clerk for Kenyon & Kenyon, of counsel for defendant cross-appellee in the above named case, and my duties familiarize me with the proceedings taken in suits in which Kenyon & Kenyon are of counsel. I am familiar with the proceedings that have been had in the above named case. On July 8th, 1905, a decree was signed by his
66 Honor Judge Lacombe, a true copy of this decree I produce herewith and attach to this affidavit. Thereafter on the 8th day of August, 1905, an appeal was taken by the complainant. True copies of the appeal, assignment of errors and the citation are hereto attached.

JOHN O. GEMPLER.

Sworn to and subscribed before me this 9th day of October, 1905.

[SEAL.] EDWIN SEGER,
Notary Public for Kings County,
Certificate in New York County.

Exhibit K.

67

At a Stated Term of the Circuit Court of the United States, in and for the Southern District of New York, in the Second Judicial Circuit, held in the Court Rooms of the said Court, in the City of New York, within said District, on the 8th day of July, 1905.

Present—Hon. E. HENRY LACOMBE, *Circuit Judge.*

NATIONAL ENAMELING AND STAMPING COMPANY and LALANCE & GROSJEAN MANUFACTURING COMPANY,
Complainants,

AGAINST

NEW ENGLAND ENAMELING COMPANY,
Defendant.

68

In Equity.

This cause having come on for final hearing upon the amended bill of complaint, the answer thereto 69
of the defendant, the replication of the complainants to such answer, and the proofs taken and other proceedings had both on the part of the complainants and on the part of the defendant, and Mr. Arthur v. Briesen and Mr. Louis Marshall having been heard on behalf of the complainant National Enameling and Stamping Company, and Mr. Walter D. Edmonds, on behalf of the complainant Lalance & Grosjean Manufacturing Company, and Messrs. Wm. Houston Kenyon, Robert N. Kenyon, Jacob Steinhardt and Walter F. Rogers, having been heard on behalf of the defendant,

70 Now, therefore, upon due consideration thereof and on motion of Messrs. Guggenheimer, Untermyer & Marshall, solicitors for National Enameling and Stamping Company, and of Mr. Walter D. Edmonds, solicitor for Lalance & Grosjean Manufacturing Company, the complainants herein, and after due deliberation had, it is hereby

Ordered, adjudged and decreed that Letters Patent of the United States issued to Hubert Claus on the 9th day of October, 1894, numbered 527,361 for improvement in enameling metal-ware are, as to claims 4, 5, 6, 7, 8, 9, 10, 11 and 12, good and valid in law, and that the above named complainants herein are entitled to the exclusive right in, to and
71 under said Letters Patent, and in and to the inventions and improvements described in said claims of said Letters Patent and secured thereby, and that the title to the said Letters Patent is duly vested in the said complainants, National Enameling and Stamping Company and Lalance & Grosjean Manufacturing Company as co-owners thereof; and that the defendant New England Enameling Company has infringed upon the fourth, fifth, sixth, seventh and eighth claims of said Letters Patent and upon the complainants' exclusive rights thereunder, by making, using and vending to others to be used articles of enameled metal-ware made according to and embodying and containing the inventions and
72 improvements described in said Letters Patent and claimed in the fourth, fifth, sixth, seventh and eighth claims thereof; and it is further

Ordered, adjudged and decreed that the said Letters Patent No. 527,361, are, as to the first, second and third claims thereof, invalid and void because claiming that of which the said Hubert Claus was not the original or first inventor or discoverer; and that the defendant has not infringed upon the ninth, tenth, eleventh and twelfth claims of said Letters Patent; and that as to the said first, second, third, ninth, tenth, eleventh and twelfth claims of said

Letters Patent No. 527,361, the bill of complaint is 73
dismissed.

It is therefore ordered, adjudged and decreed that the complainants, National Enameling and Stamping Company and Lalance & Grosjean Manufacturing Company do each respectively and in proportion to their respective interests in said Letters Patent, recover from the said defendant, New England Enameling Company, the gains, profits, savings and advantages, which the said defendant has derived, received or made by reason of any infringement by it of complainants' said exclusive rights secured to them by the aforesaid claims or any of them, being said claims numbered fourth, fifth, sixth, seventh and eighth of said Let- 74
ters Patent during the six years before the filing of the bill of complaint herein, or since the 18th day of March, 1897, that is to say, by any manufacture, use or sale of articles of enameled metal-ware containing the inventions and improvements, or any of them, described in said Letters Patent and claimed in the fourth, fifth, sixth, seventh and eighth claims thereof, and in addition to said profits, the damages which they, the said complainants have each of them respectively sustained by reason of said infringements by the said defendant of their exclusive rights since said 18th day of March, 1897.

And it is hereby referred, because of his familiarity with the subject and convenient 75
access to exhibits and files, to John A. Shields, Esq., as a Master of this Court, to ascertain, take and state the number of said articles of enameled metal-ware made, and the number sold and the number used by the said defendant in infringement of the said fourth, fifth, sixth, seventh and eighth claims of said Letters Patent or any of them, and also the gains, profits, savings and advantages made and derived by the said defendant from and through such infringement, and also to ascertain and assess the respective damages

76 sustained by each of the said complainants respectively by reason of such infringement since said 18th day of March, 1897, and to report thereon to this Court with all convenient speed.

And the said defendant New England Enameling Company, its officers, directors, clerks, agents, servants, salesmen and employees, and each and all of them, are hereby directed and required to attend before the said Master from time to time as by him required, and to produce before him, all such books, papers, exhibits, accounts, orders, statements, vouchers or other writings or documents as they may be directed by the said Master so to produce, and to submit to such oral examination as the said
77 Master may direct; and it is further

Ordered, adjudged and decreed that a permanent injunction be issued out of and under the seal of this Court enjoining and restraining the defendant New England Enameling Company, its officers, directors, clerks, agents, servants, salesmen and employees and each of them, and all claiming or holding under them or either of them, from in any form or manner whatsoever, directly or indirectly, making, using or vending to others to be used, articles of enameled metal-ware embodying and containing the inventions and improvements, or any of them, described in said Letters Patent of the United States to Hubert Claus, dated October 9, 1894, numbered
78 527,361, for improvement in enameling metal-ware, and claimed in the fourth, fifth, sixth, seventh and eighth claims thereof, or any of them; and it is further

Ordered, adjudged and decreed that neither party in this cause recover as against the other any costs, charges and disbursements heretofore incurred herein.

E. Henry Lacombe,
U. S. Circuit Judge.

Exhibit L.

79

UNITED STATES CIRCUIT COURT OF APPEALS,

FOR THE SECOND CIRCUIT.

NATIONAL ENAMELING AND STAMPING COMPANY and LALANCE & GROSJEAN MANUFACTURING COMPANY,
Complainants-Appellants,

AGAINST

80

NEW ENGLAND ENAMELING COMPANY,
Defendant-Appellant.

I, WILLIAM PARKIN, Clerk of the United States Circuit Court of Appeals for the Second Circuit, do hereby certify that on the 5th day of September, 1905 the transcript of record in cross-appeals in the above cause was received from the Clerk of the Circuit Court of the United States for the Southern District of New York and filed in my office; that on the same day I notified each of the respective parties that the estimate of one-half of the cost 81
of printing the record was $450.; that on the 14th day of September 1905 I received from the above named complainants-appellants $450. and on the 16th day of September 1905 from the defendant-appellant the further sum of $450., in all $900. which latter sum was the estimated cost of printing the said transcript of record.

Dated, New York, October 12th 1905.

WM. PARKIN,
Clerk of United States Circuit
Court of Appeals—Second Circuit.

[SEAL.]

Exhibit L.

82

CIRCUIT COURT OF THE UNITED STATES,

SOUTHERN DISTRICT OF NEW YORK.

NATIONAL ENAMELING AND STAMPING COMPANY and LALANCE & GROSJEAN MANUFACTURING COMPANY, Complainants,	In Equity.
AGAINST	
83 NEW ENGLAND ENAMELING COMPANY, Defendant.	

I, JOHN A. SHIELDS, Clerk of the Circuit Court of the United States for the Southern District of New York, do hereby certify that upon the filing in my office of the respective assignments of errors, citation and petition and allowance of appeal of each of the respective parties upon cross appeals in the above entitled cause, and pursuant to the joint request of the respective parties, I prepared the tran-
84 script of record in the above cause to be filed with the Clerk of the United States Circuit Court of Appeals for the Second Circuit and that my fees for such transcript of record were $919.20; that I notified the respective parties of their one-half shares of such fees and that I have received from the complainants $459.60 and from the defendant $459.60 in full payment of my fees.

Dated New York, October 12, 1905.

JOHN A. SHIELDS,
[SEAL.] Clerk of the U. S. Circuit Court,
Southern District of New York.

Exhibit M.

85

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE SECOND CIRCUIT.

NATIONAL ENAMELING AND STAMPING COMPANY and LALANCE & GROSJEAN MANUFACTURING COMPANY,
Complainants-Cross-Appellants,

AGAINST

NEW ENGLAND ENAMELING COMPANY,
Defendant-Cross-Appellee.

Present—Judges WALLACE AND COXE. 86

Upon reading and filing the motion of the New England Enameling Company, defendant-cross-appellee, to dismiss the cross appeal of the National Enameling and Stamping Company and the Lalance & Grosjean Manufacturing Company, on the ground that this Court has no jurisdiction to entertain said appeal, and the affidavit of John O. Gempler in support thereof, and the exhibits annexed thereto, to wit, the cross-appeal of the National Enameling and Stamping Company and the Lalance & Grosjean Manufacturing Company, complainants, the citation issued in connection therewith to the New England Enameling Company, and the assignment of errors filed in connection with said appeal, and the decree of the United States Circuit Court for the Southern District of New York, from which said appeal was taken, and the certificates of the Clerk of the United States Circuit 87

88 Court of Appeals for the Second Circuit and the Clerk of the Circuit Court of the United States for the Southern District of New York, in opposition thereto, and after hearing Robert N. Kenyon, Esq., in support of said motion, and Walter D. Edmonds, Esq., and Louis Marshall, Esq., in opposition thereto; now, upon motion of Messrs. Steinhardt & Goldman, solicitors for defendant-cross-appellee, and after due consideration had, it is

Ordered, that said motion be granted and that the cross-appeal of the complainants National Enameling and Stamping Company and the Lalance & Grosjean Manufacturing Company in the above entitled cause be, and the same hereby is, dismissed
89 on the ground that this Court has no jurisdiction to entertain said appeal.

Dated New York, January 3, 1906.

(Endorsed)—Filed January 3, 1906.

FOLDOUT(S) IS/ARE TOO LARGE TO BE FILMED

[redacted]

Supreme Court of the United States.

OCTOBER TERM 1905.

No. 17 ORIGINAL.

Ex Parte:

IN THE MATTER

OF

THE NATIONAL ENAMELING & STAMPING CO. and THE LALANCE AND GROSJEAN MANUFACTURING CO., Petitioners.

The Answer of the Judges of the United States Circuit Court of Appeals of the Second Circuit, to the Rule to show cause why a writ of mandamus should not be granted as prayed in the petition of the National Enameling and Stamping Co. and the Lalance and Grosjean Manufacturing Co., heretofore filed in the above entitled cause.

The Respondents respectfully answer and certify to the Honorable, the Supreme Court of the United States:

1. In answer to the allegations of the petitioners above named, the Respondents respectfully refer to the papers on the cross-appeal, the motion to dismiss said cross-appeal and the papers annexed thereto, and the order of the United States Circuit Court of Ap-

peals for the Second Circuit, dismissing said cross-appeal, all of which are annexed to said petition.

2. Respondents are advised that it is not necessary that they should make any other answer to the rule aforesaid than this herein contained, nor more specifically to any of the allegations set forth in the Petition for mandamus aforesaid; and having finally answered said rule, they pray to be hence dismissed with all proper costs; respectfully submitting to the judgment of this Honorable Court, they will enforce by order, any direction given by the court in the premises.

3. Respondents respectfully refer to brief of counsel for the New England Enameling Co. filed in this Honorable Court and the authorities referred to therein, in support of the dismissal of the cross-appeal.

WILLIAM J. WALLACE.
ALFRED C. COXE.

(SEAL).
WM. PARKIN,
Clerk.

Supreme Court of the United States,

OCTOBER TERM, 1905.

Ex Parte The National Enameling and Stamping Company and the Lalance & Grosjean Manufacturing Company.	No. 17. Original.

Petitioners' Points.

This application for a writ of mandamus brings up the question as to whether the Judges of the Circuit Court of Appeals for the Second Circuit were justified in dismissing petitioners' cross-appeal from a decree of the United States Circuit Court on the ground of lack of jurisdiction to entertain it.

The facts are briefly: In the petitioners' suit in equity brought in the United States Circuit Court for the Southern District of New York against the defendant New England Enameling Company to restrain infringement of United States Letters Patent No. 527,361, issued to Hubert Claus, on pleadings and proofs and argument had, a decree was entered on July 8, 1905 (*pp. 23-26*), sustaining the validity of claims 4, 5, 6, 7 and 8 of the

patent, adjudging them infringed, and enjoining defendants and directing an accounting, &c., thereunder (*fols. 70-72, 73-78*).

The decree also contained the following provision (*fol. 72*):

> "And it is further
>
> ORDERED, adjudged and decreed that the said Letters Patent No. 527,361 are, as to the first, second, and third claims thereof, invalid, and void because claiming that of which said Hubert Claus was not the original or first inventor or discoverer; and that the defendant has not infringed upon the ninth, tenth, eleventh and twelfth claims of said Letters Patent; and that as to the said first, second, third, ninth, tenth, eleventh and twelfth claims of said Letters Patent No. 527,361, the bill of complaint is dismissed."

The defendant New England Enameling Company thereupon appealed, not exclusively from the said decree or order granting said injunction, but generally, and on the merits, from the decree against it, including the accounting, &c., and prayed that the "*said decree* of said Circuit Court be reversed," &c. (*pp. 8 to 13*).

Thereupon petitioners perfected their cross-appeal from so much of said decree as dismissed their bill on the ground that claims 1, 2 and 3 were invalid, and that claims 9, 10, 11 and 12 had not been infringed (*pp. 14 to 18*).

The voluminous record on appeal, 3093 pages, was thereupon prepared by the clerks of the respective courts at a cost of $1,819.20, one-half of which $909.60 was by the clerks assessed against petitioners and paid by them, and the remaining half by the defendant New England Enameling Company (*pp. 27-28*).

The defendants thereupon moved the Circuit Court of Appeals to "dismiss the said appeal * * * for want of jurisdiction thereover" (*pp. 20, 21*).

The motion was argued by both parties on the 16th day of October, 1905, and briefs filed, after which, on the 21st day of December, 1905, the Court, without delivering any opinion, rendered its decision dismissing the petitioners' cross-appeal on the express ground of lack of jurisdiction to entertain it, as appears by the order entered in the cause on January 3, 1906 (*pp. 29, 30*).

The petitioners' contentions are:

First.—The Circuit Court of Appeals had jurisdiction to entertain petitioners' cross-appeal, whether the decree be viewed as a final or interlocutory decision, since the defendants' appeal, under Section 7 of the Act to Establish Circuit Courts of Appeals, as amended, "conferred upon the Court authority to consider and decide the case upon its merits," and thus opened the door for petitioners' cross-appeal.

Second.—The Circuit Court of Appeals had jurisdiction, because the decree of July 8, 1905, was, in so far as it finally dismissed petitioners' bill, as to certain specified claims of the patent in suit, a final decision within the meaning of that term, and within the meaning of the act establishing the appellate jurisdiction of said Court.

POINTS.

I.

Mandamus is the proper remedy where, as here, a court refuses to act in a matter properly before it, or to take jurisdiction in a proper case, and from such refusal no writ of error or appeal will lie.

Insurance Co. v. *Comstock, 16 Wall., 258, 271.*
Matter of Christensen Engineering Co., 194 U. S., 458.
Ex parte Hollon Parker, 131 U. S., 221.
Re Farmers Loan & Trust Co., 129 U. S., 206.
Re Hohorst, 150 U. S., 653.

In *Ex Parte Holon Parker* (*supra*), the petitioner applied for a writ of mandamus to the Supreme Court of Washington Territory, to reinstate an appeal to that court from a judgment of the District Court of the Territory, the Territorial Supreme Court having dismissed the appeal. It was objected that the mandamus was not the proper remedy. The writ was nevertheless granted, Mr. Justice Field saying:

> "The writ of mandamus lies, as held in *Ex parte Parker*, 120 U. S., 737, where an inferior court refuses to take jurisdiction when by law it ought to do so, or where, having obtained jurisdiction, it refuses to proceed in its exercise."

The contention that *ultimately*, after accounting

&c., the decree which petitioners desire to appeal from *now*, may be repeated in a so-called "final decree," and *then* appealed from, will depend on whether this Court holds that part of the decree of July 8, 1905, which dismisses the bill, to be final or interlocutory.

But this Court has hitherto maintained that such contention constitutes no impediment to the issue of the mandamus.

In re Hohorst, 150 U. S., 653.

There the appeal of the petitioner, Hohorst, had been previously dismissed as being from a decision not final, since it remained for him to proceed with an accounting against some of the defendants before entry of final decree (Hohorst *vs.* Hamburg-American Packet Company, 148 U. S., 262).

Hohorst thereupon insisted, that he was remediless except through mandamus, because unable to have forthwith, and prior to such accounting, an appealable decree, dismissing his bill against one of his defendants for lack of jurisdiction. On these considerations, equally present in the case at bar, this Court followed its previous ruling in *Shaw* v. *Quincy Mining Co.* (*145 U. S., 444*) and granted the mandamus.

II.

Jurisdiction to entertain petitioners' cross-appeal logically and reasonably follows from the principles laid down in Smith vs. Vulcan Iron Works, 165 U. S., 518.

Prior to the decision in that case, the Courts

of Appeals in several of the circuits quite generally dismissed, for want of jurisdiction, cross-appeals like that of petitioners herein. In some of the circuits, and especially in the Second Circuit, the courts have persisted in this practice, as witness for instance the case at bar.

See also

Marden v. Campbell, 67 F. R., 809 (1st Circuit).
Western Elec. Co. v. Williams Abbott Co., 108 F. R., 952 (6th Circuit).
Dowagiac Co. v. Superior Co., 115 F. R., 890 (6th Circuit).
Thompson-Houston Co. v. Nassau E. Co., 112 F. R., 676 (2d Circuit).
Mfg. Co. v. Griswold, 67 Fed., 1017.

Since the decision on *Smith vs. Vulcan Iron Works, supra,* however, a diametrically different practice has been established in at least the Seventh and Fourth Circuits, where motions to dismiss such cross-appeals have been denied, and jurisdiction has been assumed on cross-appeals like that taken by the petitioners to hear and dispose finally of the entire case upon the merits.

Chicago Wooden Ware Co. v. Miller Co., 133 F. R., 541.
Scriven v. North, 134 F. R., 366.

In *Smith vs. Vulcan Iron Works,* which was for infringement of patent, it was held that by an appeal from an interlocutory order or decree granting an injunction under Section 7, jurisdiction is conferred on the Circuit Court of Appeals "to consider and decide the case upon its merits" (p. 525), *i. e.,* not only to review such order or decree, but also to finally dismiss the bill, and thus, as was done there to *finally* dispose of the suit.

It is submitted that jurisdiction to thus review the case on its merits, must logically include not only power to thus dismiss the bill, but also to comprehensively review and finally dispose of every issue presented by the record, relating to complainants' right to injunction, and thus to pass finally upon the validity and infringement of every claim of the patent.

Confidence is felt in the correctness of this assertion because this Court, in *Smith vs. Vulcan Works* cited with approval *Bissell Carpet-Sweeper Co. v. Goshen Sweeper Co.* (*72 Fed. Rep., 545*), in which Judge Lurton, for the Circuit Court of Appeals, Sixth Circuit, had in March, 1896, employed the following forcible and pertinent language:

> "If, under an appeal from a decree awarding an injunction, this Court obtains such a "record as to enable it, with justice to the "parties to the appeal, to hear and consider "the merits of the cause, it would be most "anomalous if we have not the power to de"cide. The judicial function of considering "involves the function of determining. The "decision of an Appellate Court is final, and "no second appeal is maintainable, except as "to matters reserved, or proceedings subse"quent to the first appeal" (p. 560).

Our understanding of *Smith* vs. *Vulcan Works* is in accord with that of the Circuit Court of Appeals of the Seventh Circuit as expressed in *Chicago Wooden Ware Co.* vs. *Miller Co.* (*133 Fed. Rep., 541*). There the circumstances being substantially identical with those at bar, on motion to dismiss cross-appeal, the Court said:

> "Smith *vs.* Vulcan Iron Works, 165 U. S., "578, wherein it was held that on an appeal "from a decree like this the appellate tribun"al with all the pleadings and all the evidence "before it for an independent hearing, had

"'authority to consider and decide the case "'upon its merits,' to the end that the parties "might be saved the time, trouble and ex- "pense that would be involved in carrying on "further litigation in the Circuit Court in a "way that was contrary to the views of the "Court of Appeals on the ultimate merits. "Here defendants present a complete record, "containing all the pleadings and proofs. "They do not attack merely the injunction "respecting the second patent, and that on "the ground that it was temporary, and im- "providently issued; but they contend that, "as to the five claims of the two patents held "valid, the ultimate merits of the question of "validity and infringement are in their "favor. If we were not authorized now to "consider and decide the merits with respect "to claim 1 of the first patent, which was in- "cluded in the pleadings and proofs and "held invalid, the result would be that the "Circuit Court would proceed with the ac- "counting on a basis that does not accord "with our views of the ultimate merits, and "a new accountng would have to be taken "after a subsequent appeal to this Court. "Motion overruled" (pp. 544, 545).

In the Fourth Circuit the same result was arrived at in *Scriven* v. *North* (*supra*), though by a somewhat different reasoning. There, also, defendants' motion to dismiss complainants' appeal from parts of an otherwise interlocutory decree dismissing bill was denied, and jurisdiction retained.

Petitioners may well concede that they cannot *on their own initiative,* create the status on which depends the jurisdiction referred to. It might, possibly, violate established precedent to permit *in the first instance,* from unacceptable parts of an interlocutory decree to "try the case piecemeal." But this is distinctly not the present situ-

ation. The status conferring "jurisdiction over the entire case" has been created solely on the defendant's own initiative, by availing itself of the privilege accorded to it alone, by Section 7.

By taking such appeal, the decree dismissing the bill, as to the claims found to be void, and not infringed, does not become isolated, but it is stamped as a "final decision" within the meaning of Section 6 of the Act of March 3, 1891, and can therefore be brought up on a cross-appeal, Thus the incongruity of finding the decree, in so far as it is adverse to the defendant, in the Appellate Court, and in so far as it is adverse to the complainant in the court of first instance, is avoided, and an adjudication "piece-meal" with all that is implied in that term, and with all its latent possibilities, is prevented.

It was purely optional with defendant to either avail itself of this, its peculiar privilege, or, without prejudice, postpone its appeal until final decree. In the latter event, unquestionably, this Court must then review and on a single hearing dispose of all the claims upon the merits. It will be observed, therefore, that the hearing of this case "piecemeal" would occur, if at all, only by reason of the defendant's action in having at this stage of the case carried it to the Appellate Court, and the refusal of the Court of Appeals to entertain the petitioner's cross-appeal; whereas the assumption of jurisdiction over such appeal, will enable the appellate tribunal to consider the merits of the entire case, once for all.

It is obvious that the result of dismissing complainants' present appeal, and thereby segregating out of the case, for the present, the issues respecting claims 1, 2, 3, 9, 10, 11 and 12, may involve at least two accountings, and also from one to three additional appeals, whereas a compre-

hensive review of the entire case on the present appeal will either in itself finally dispose of the case or lead to only one accounting and appeal therefrom.

A result even more serious would occur, if the appellate court, acting under the power which it possesses by virtue of the rule laid down in *Smith* v. *Vulcan Iron Works,* should dismiss the bill of complaint on the defendant's appeal. In such an event, the petitioners would find themselves out of court, without having had an opportunity of presenting their contentions with respect to the claims as to which the lower court had already dismissed the bill of complaint.

Non constat if the entire case, upon its merits, that is the case as it was presented for consideration to the court of original jurisdiction, were before the appellate tribunal, the latter might sustain the bill of complaint on the basis of the claims which the court of first instance may have adjudged to be either void or not infringed, even though the views of the appellate tribunal as to the claims sustained by the lower court, might be utterly at variance with those embodied in the decree appealed from.

It would be attributing to Congress a most extraordinary intention, to predicate upon its language, construed as it has been by this court, these possible consequences.

An obvious additional hardship would result from a division and partial review of the patent at this juncture. The legal presumption of the novelty and utility of Claus' invention abstractly considered has been confirmed by the Circuit Court. It is, at this point, *res adjudicata* between those parties that a new and useful invention was disclosed to the world by Claus' specification. Should the Circuit Court of Appeals opine that

the Court below erred in its selection of the claims most proper to protect it, precedent and justice demand that the remaining claims be simultaneously reviewed, on the merits, to determine whether they are not sufficient to protect the inventor.

Consider also the burden upon the Court, to say nothing of litigants, of several reviews of the whole of this exceptionally difficult and complex case involving a printed record of 3,093 pages, in order to determine separately, and at different hearings, the validity of different claims.

Consider also that, pending final decree on accounting, complainants are, by dismissal of their bill upon claims 1, 2, 3, 9, 10, 11 and 12, as effectively deprived of their property therein, as though it had been material and taken from them by execution, thus bringing this case within the exception recognized by this Court in *Forgay* v. *Conrad, 6 Howard, 201.*

See *Scriven* v. *North, 134 Fed. Rep., 366.*

It would thus appear that the granting of this mandamus is demanded by every consideration of equity, expediency, and orderly and economical administration of justice.

Finally, it will be observed, in this connection, that defendant's appeal is, by its assignment of errors, expressly taken, not merely from the injunction, but also broadly upon the merits (fols. 30 to 37), thus necessitating a review of the entire record, with the limited result, as they now egregiously contend, of passing solely upon five only out of a total of twelve claims still in controversy.

The effect of the Act of March 3, 1891,

Chapter 517, establishing Circuit Courts of Appeals, and especially of Sections 6 and 7, now under consideration, is to make applicable to appeals taken under that section, the practice in equity as formerly administered in the Courts of Chancery in England and of the State of New York, and in the House of Lords, of examining the merits of the cause and of passing upon the rights of the respective parties to the subject-matter of litigation, in order to save both parties the needless expense incident to a protracted and unnecessary litigation, and the appellate courts the labor and inconvenience of reviewing decrees of inferior courts on repeated appeals, to say nothing of the complications likely to result from successive appeals, by which fractional parts of the decree, or of the issues involved in the litigation, are presented to the appellate tribunals for consideration.

In *Smith* v. *Vulcan Iron Works* (*supra*), this practice was reinstated in its application to the question as to whether or not, on an appeal from an interlocutory order or decree granting an injunction and ordering an account in a patent case, the Circuit Court of Appeals might decide the case on its merits, and render a final decree dismissing the bill.

The logical conclusion from this decision would seem to be, that on such an appeal the Circuit Court of Appeals is not confined to a dismissal of the bill, but, if the entire record in the cause is before it, may grant such relief to both of the parties as the record indicates them to be entitled to.

This seems to have been the view of the Court in *Bissell Carpet Sweeper Co.* v. *Goshen Carpet Sweeper Co.* (*supra*), which was considered in

Smith v. *Vulcan Iron Works* (*supra*), where Judge Lurton said:

> "It is proper therefore to assume that when Congress undertook to enlarge the right of appeal, it did so in the full light of the history of appeals in equity cases, and with a full appreciation of the distinction between interlocutory orders or decrees and final decrees."

In *2 Daniell's Chancery Pleading & Practice, Sixth American Edition, p. 1489,* the English practice on appeals in Chancery cases is stated as follows:

> "Upon a rehearing or appeal the whole case is open to the respondent, so that, if the appeal is against the whole decree it is competent for the Court to modify the decree by making it more favorable to the respondent. Thus, where a plaintiff, who was successful in obtaining a decision against the defendant, with costs, not being satisfied with the view which the Vice-Chancellor had taken of the case, had the cause reheard before Lord Cottenham, in order to obtain an alteration in the decree more favorable to himself, his lordship, upon the rehearing, being of opinion that the plaintiff was not entitled to any relief at all, dismissed his bill, with costs (*Oldham* v. *Stonehouse, 3 M. & C., 317*). * * * So where the appeal is against part of the decree only the respondent may, if he considers it necessary, go into the whole case, whilst the appellant can only go into the parts complained of in his petition. Therefore, where there were two questions in the cause, one being whether the executor was entitled to surplus, and the other whether a legacy given to him by the will was in satisfaction of a debt due to him by the testator, and upon the first point the Court decided against him because he had put in an answer in which he admitted himself acountable for the surplus, but the second point was deter-

> mined in his favor, whereupon the plaintiff appealed against the last decree, Lord Cowper held that it was competent for the defendant to go into the first point, though he eventually did not decide in his favor (*Rawlins* v. *Powell, 1 P. Wms., 293, 300*)."

The rule has been stated in *Hunter* v. *Belcher, 2 DeGex J. & S., 201,* that the Appellate Court may make a decree as upon a trial *de novo.*

In *Sherwin* v. *Shakspear, 5 DeGex M. & G., 523,* Lord Justice Knight Bruce said:

> "I have no doubt on the point, that upon an appeal from part of a decree the whole case is open to the respondent. He may be satisfied with the decree as it stands, but that does not prevent him from contending, if its correctness is called in question in any particular, that it should be made more favorable to him in any other."

In *LeGuen* v. *Gouverneur, 1 Johnson's Cases, 436,* decided in 1800, when Chancellor Kent was a member of the Court of Errors, that learned jurist declared:

> "It is the settled rule of the House of Lords in England, upon appeals, always to give such a decree as the Court below ought to have given. This was the great and leading maxim in their system of appellate jurisprudence, and instances are, accordingly, very frequent, in which the Lords on appeals from interlocutory orders in Chancery, have reversed the order and decided fully on the merits. * * * Possessing the authority to decide finally, I think we ought to exercise it in this instance. * * * *All the proofs are before us.* * * * *The cause is as ripe here as it was in the Court below for ultimate decision.*"

In the same case Mr. Justice Radcliff said (p. 499):

> "I have also no doubt that this Court may proceed further, if it appear that the merits are fully in its possession, and determine finally between the parties. That such is the power, and frequently the practice, of the House of Lords in England, is evident from the cases which have been cited. * * * On similar appeals, they affirm, reverse, or alter the order for an issue, and sometimes proceed to dismiss the bill, or otherwise decree on the merits. The power of this Court is the same in this respect. I can see nothing in our constitution or laws to restrain it. * * * In this case, the propriety of making a final decree arises out of the appeal itself, which brings before us the whole merits of the cause. * * * The power in the last resort, and I have no doubt that it appears to me essential to a court of appeal is vested here."

In *Consequa* v. *Fanning, 3 Johns. Ch., 587*, Chancellor Kent said:

> "There is considerable variation in the objections made to the decree as stated in the petition for a rehearing, and in the points on which the cause was reargued. But I apprehend the rule to be well settled, that upon a rehearing, the cause, with respect to the party who petitions to rehear, is open only to those parts of it complained of in the petition; though, as to the other party, it is open as to the whole matter of the decree. The rule was so declared by Lord Chancellor Cowper in *Rawlins* v. *Powell, 1 P. Wms., 300*, and it is to be met with in all the subsequent treatises on the subject."

In *Dale* v. *Roosevelt, 6 Johns. Ch. 255*, the same doctrine was restated, the Chancellor saying:

> "On a rehearing the cause is entirely open

> as to the party in whose favor the former decree was given; and as to the other party, it is open only in respect to the parts of the decree complained of."

Chancellor Walworth approved of *Consequa* v. *Fanning* (*supra*) in *Ferguson* v. *Kimball, 3 Barb. Ch., 616.*

In more recent times the practice on appeal in English Chancery cases has been liberalized to even a greater degree than as above stated, a reference to the authorities being useful as indicating the present tendency.

In *1 Daniell's Chancery Practice, 7th Ed., p. 1075*, the author says:

> "An appeal being by way of rehearing, the court of appeal is not confined to the points mentioned in the notice of appeal. The court of appeal has all the powers and duties as to the amendment and otherwise of the High Court, and has power to draw inferences of fact and to give any judgment and make any order which ought to have been made, and to make such further or other order as the case may require, and no interlocutory order or rule from which there has been no appeal is to operate so as to bar or prejudice the court of appeal from giving such decision upon appeal as may be best."

The Orders of Court, LVIII., 4, are to the effect that the above mentioned powers may be exercised by the Court of Appeal, notwithstanding the notice of appeal may pray that part only of the decision may be reversed or reviewed, and that such powers may also be exercised in favor of all or any of the respondents or parties.

III.

The Circuit Court of Appeals erred in dismissing petitioners' appeal, because it had jurisdiction to entertain and determine it; the decree of July 8, 1905, in so far as it dismissed petitioners' bill as to all matters determined by it respecting claims 1, 2, and 3 and 9, 10, 11, 12, being in substance and effect, a "final decision," within the meaning of that term, as used in the act, respecting the appellate jurisdiction of said Court.

Forgay, v. Conrad, 6 How., 201.
Hill v. Chicago & Evanstown R. R. Co., 140 U. S., 52.

The decree expressly declares that:

> "As to the first, second, third, ninth, "tenth, eleventh and twelfth claims of said "Letters Patent No. 527,361, *the bill of com-"plaint is dismissed.* * * *
>
> "And it is further ordered, adjudged and "decreed that neither party in this cause re-"cover as against the other any costs, charges "and disbursements heretofore incurred "herein."

In referring the accounting to the Master the decree omits the usual words to the effect that "all other and further questions not determined by this decree be reserved until the coming in of the Master's report."

Accounting herein has not yet begun, and obviously it could not possibly be terminated, and final

decree thereon entered within six months after July 8, 1905.

In *Forgay* v. *Conrad, supra,* though the decree therein entered was classifiable as "*interlocutory,*" since it directed an accounting by a Master, this Court nevertheless treated it as an appealable final decision, partly in consideration of its awarding execution whereby title to property might be divested.

It is submitted that the decree herein, in so far as it invalidates claims 1, 2 and 3 of the Claus patent, equally divests complainants of their property, *viz.,* the exclusive right to use, &c., the invention purporting to be covered by these claims. The resulting loss may be irreparable.

In *Hill* vs. *Chicago, &c., R. R. Co.* (*supra*), this Court held that a so-called interlocutory decree dismissing the bill as to certain defendants and upon "all matters and things in controversy," except an amount to be paid as ascertained by an accounting thereby directed, was, in effect and substance, final, except as to such accounting, and that the time within which to appeal from the decisions therein made, began to run from its entry instead of from the time of the entry of the so-called final decree rendered after the accounting, two years later.

In *Scriven* vs. *North* (*supra*), a suit for infringement of patent, trademark and other property rights, the Circuit Court of Appeals of Fourth Circuit followed the principles enunciated by the two cases referred to, and permitted immediate appeal from those parts of the interlocutory decree which dismissed the bill.

It is thought unnecessary to enlarge further upon those peculiarities of the decree at bar which bring it within the foregoing definitions of a "final decision." It "orders, adjudges and decrees" the

dismissal of the bill upon certain specified claims, each in fact a separate patent, and cause of action; (*United Nickel Co.* v. *California Works, 25 Fed. Rep., 475, 479*). It is, in its terms, absolutely comprehensive and conclusive as to that part of the bill. It is manifest that a final decree entered after the accounting, could neither add nor subtract, one jot or one tittle, from the finality of the adjudication thus made by this so-called interlocutory decree. There is absolutely nothing left to be determined by the Circuit Court, except the amount of the recovery for infringement of claims 4, 5, 6, 7, 8.

Even the question of costs, left open in the *Scriven* case, has here been finally adjudicated by the Circuit Court.

Should the appeal which the petitioners are now seeking to take, be dismissed and the case should after the entry of a so-called final judgment, ultimately reach the United Circuit of Appeals, petitioners would find themselves remediless, should it be decided, as in the cases cited, that the decree of July 8, 1905, herein, was final in so far as it dismissed the bill, and that petitioners' time to appeal therefrom had expired.

The decision of the United States Circuit Court is "final", as to that part of the decree, which dismissed the bill of complaint. It was "interlocutory", as to that part of the decree only, which was adverse to the defendants, and which has been appealed pursuant to the express authority of Section 7. As to the latter an accounting was directed, but none the less the decree has been made reviewable without waiting for the result of the accounting. As to the former within the rule of *Bosturek* vs. *Brinckerhoff, 106 U. S., 3*, it has terminated the litigation as to the subjects with which it deals, on the merits of the case, so that, if there

should be an affirmance of it, on appeal, "the court below would have nothing to do but to execute the judgment or decree it had already rendered." Hence, the determination of the Court of Appeals, dismissing the petitioners' cross-appeal, involves the paradox, that it can review a decree to the extent that it is "interlocutory," but not those features of it, as to which it is unquestionably "final," even though both portions of the decree are based on the self-same record.

IV.

The prayer of the petition should be granted and a peremptory mandamus issue that the Circuit Court of Appeals of the Second Circuit shall entertain and determine the petitioners' cross-appeal.

Arthur v. Briesen,
Louis Marshall,
Walter D. Edmonds,
Of Counsel for Petitioners.

FILE COPY.

Supreme Court of the United States.

OCTOBER TERM, 1905.

No. 17 ORIGINAL.

Office Supreme Court U.
FILED
FEB 19 1906
JAMES H. McKENNEY,
Cl.

Ex Parte.

THE NATIONAL ENAMELING AND STAMPING COMPANY and THE LALANCE AND GROSJEAN MANUFACTURING COMPANY,

Petitioners.

Brief on Behalf of New England Enameling Company in Opposition to Petition for Mandamus.

ROBERT N. KENYON,
WALTER F. ROGERS,
JACOB STEINHARDT,
Of Counsel for New England Enameling Company.

C. G. Burgoyne, Walker and Centre Streets, N. Y.

Supreme Court of the United States.

Ex parte THE NATIONAL ENAMELING AND STAMPING COMPANY and the LALANCE & GROSJEAN MANUFACTURING COMPANY.	Original, No. 17.

BRIEF ON BEHALF OF NEW ENGLAND ENAMELING COMPANY IN OPPOSITION TO PETITION FOR MANDAMUS.

This is a petition filed by The National Enameling and Stamping Co. and the Lalance & Grosjean Manufacturing Company, the complainants in a suit brought in the United States Circuit Court for the Southern District of New York, for infringement of Patent of Claus No. 527,361 against the New England Enameling Co., defendant, for a mandamus commanding the Judges of the United States Circuit Court of Appeals for the Second Circuit to reinstate and take jurisdiction over a cross-appeal taken by said petitioners to the said Circuit Court of Appeals from so much of the decree of the Circuit Court as dismissed the Bill of Complaint as to certain claims of the patent.

On behalf of the New England Enameling Co., and in support of the order entered by said Circuit Court of Appeals, we submit that the petition should be denied.

The suit was brought on Patent No. 527,361, to Hubert Claus (see Exhibit A, annexed to Petition), and

claims 1 to 12, inclusive, were at issue. After hearing on bill, answer and proofs, an interlocutory decree was entered finding article claims 4 to 8, inclusive, valid and infringed; article claims 1 to 3, inclusive, invalid, and process claims 9 to 12, inclusive, not infringed. The decree, which is printed at page 23 of the motion papers, is the usual interlocutory decree in patent causes, granting a perpetual injunction and an accounting as to claims 4 to 8, inclusive, and dismissing the bill as to the remaining claims.

Defendant appealed under section 7 of the Judiciary Act of 1891, as amended in 1900, from so much of the decree as related to claims 4 to 8, inclusive (See Assignment of Errors, p. 10 of motion papers). Thereafter complainants appealed, praying that the decree be reversed as to claims 1, 2, 3, 9, 10, 11, 12, and that an injunction and an accounting be granted as to the same (See Motion Papers, pp. 14–17).

The Court of Appeals for the Second Circuit, on motion of defendant, dismissed the cross appeal of the complainants on the ground that it had no jurisdiction to entertain it. Thereafter the complainants petitioned this Court and obtained from it a rule on the Judges of the Court of Appeals for the Second Circuit to show cause why a writ of mandamus should not be issued, directing them to reinstate and take jurisdiction of complainants' appeal.

We contend :

First. That Section 7 of the Judiciary Act of 1891, as amended in 1890, is not ambiguous but clearly means that an appeal will lie only by the defendant who has been enjoined by an interlocutory order or decree, and for the purpose of determining whether the injunction was properly granted.

Second. That in the case of *Smith vs. Vulcan Iron Works*, 165 U. S., 518, the question whether a complainant could take a cross-appeal did not arise. That

case is not in conflict with the decisions of the Circuit Courts of Appeals denying the right of a complainant to a cross-appeal. It considered only the extent of the relief that could be given to a defendant when improperly enjoined.

THIRD. That the history of this legislation and of the times shows that it was the intention of Congress to give the right of appeal to the defendant but to deny it to the complainant.

FOURTH. That the argument of "convenience" advanced by the petitioners is wide of the mark. The question in issue is the construction of the statute.

FIFTH. That if the statute is ambiguous, it will be strictly construed against any right of appeal in the complainants, (1) because the original Statute of 1891 was uniformly construed in this way, and Congress must be held to have adopted this construction by re-enacting that law without change, (2) because the contemporaneous construction was against such right of appeal, (3) because the construction contended for by the petitioners would reverse a long-established practice and system, and would result in absurdity, and (4) because the intent of Congress is unmistakable and must control, even if it were against the literal meaning of the statute.

SIXTH. That the decree in question is not a final decree from which an appeal lies by the complainants under Section 6 of the said act, but is an interlocutory decree under the uniform decisions of this Court.

ARGUMENT.

I.

Section 7 of the Judiciary Act of 1891, as amended in 1890, is not ambiguous but clearly means that an appeal will lie only by the defendant who has been enjoined by an interlocutory order or decree, and for the purpose of determining whether the injunction was properly granted.

Our position is that no appeal from the decree herein can be entertained under Section 7 of the Judiciary Act of 1891 as amended in 1900, except an appeal taken by the party against whom the injunction operates in order to obtain speedy relief from the injunction if it was improperly granted.

If on such an appeal the issue or question which is raised by the appeal is determined favorably to the defendant, the Court can give the defendant the full relief necessarily flowing from such decision, even to the extent of dismissing the bill, but the Court cannot take jurisdiction of other issues or questions not involved in determining the propriety of the injunction.

In the judiciary act of 1891, section 6 gave jurisdiction to the courts of appeals of appeals from final decisions; section 7 provided for appeals from "interlocutory orders or decrees." The latter section was as follows (Stat. 1889-91, Ch. 517, p. 828):

> "SEC. 7. That where, upon a hearing in equity in a district court, or in an existing circuit court, *an injunction shall be granted or continued by an interlocutory order or decree*, in a cause in which an appeal from a final decree may be taken under the provisions of this act to the Circuit Court of Appeals, *an appeal may be taken from such interlocutory order or decree granting or continuing such in-*

junction to the Circuit Court of Appeals: Provided, That the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the appellate court; and the proceedings in other respects in the court below shall not be stayed unless otherwise ordered by that court during the pendency of such appeal."

In 1895 this section of the act was amended by Chapter 96 of the Statutes of 1895 to enlarge the right of appeal so as to read as follows (Stat. 1893–1895, p. 666):

"That where, upon a hearing in equity in a district court or a circuit court, *an injunction shall be granted, continued, refused, or dissolved by an interlocutory order or decree, or an application to dissolve an injunction shall be refused* in a case in which an appeal from a final decree may be taken under the provisions of this act to the Circuit Court of Appeals, *an appeal may be taken from such interlocutory order or decree, granting, continuing, refusing, dissolving or refusing to dissolve an injunction* to the Circuit Court of Appeals: Provided, that the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the appellate court; and the proceedings in other respects in the court below shall not be stayed unless otherwise ordered by that court during the pendency of such appeal; and provided further, that the court below may, in its discretion, require as a condition of the appeal, an additional injunction bond."

In 1900, by Chapter 803 of the Statutes of that year, this section of the Act of 1891 was again amended to read as follows (Stat. 1899–1901, p. 600):

"SEC. 7. That where, upon a hearing in equity, in a district court or in a circuit court, or by a judge thereof in vacation, *an injunction shall be granted or continued* or a receiver appointed, *by an*

interlocutory order or decree, in a cause in which an appeal from a final decree may be taken under the provisions of this Act to the Circuit Court of Appeals, *an appeal may be taken from such interlocutory order or decree granting or continuing such injunction*, or appointing such receiver to the Circuit Court of Appeals: Provided, that the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the Appellate Court; and the proceedings in other respects in the court below shall not be stayed, unless otherwise ordered by that court, or by the appellate court or a judge thereof, during the pendency of such appeal: Provided further, that the court below may in its discretion require as a condition of the appeal, an additional bond."

No reference was made in the Act of 1900 to the Act of 1895, the latter being necessarily repealed by the amendment in 1900 of the Act of 1891.

So far as the present issue is concerned, Section 7, as enacted in 1891, is *identical* with that section as amended in 1900. Exactly the *same words* are used in those portions of the act that need be construed on this motion. The decisions of the Courts as to the construction of the original act on the question now raised are, therefore, directly applicable to the act as now existing. More than that; the *intention of Congress* in 1900 to give to the act the same meaning as to the question now at issue that the Courts had uniformly given to the original act, is conclusively shown by the use of the exact language contained in the original act.

Under the judiciary act as *originally* enacted the exact question now before this Court had been passed upon by the Courts of Appeals for the First and Second Circuits, whose decisions were uniformly to the effect that the Court had no jurisdiction to entertain an ap-

peal by complainant from such portions of an interlocutory decree as dismissed the bill.

Marden vs. Campbell Co., 67 Fed. Rep., 809, *First Circuit.*
Kilmer Co. vs. Griswold, 67 Fed. Rep., 1017, *Second Circuit.*
Eagle Lock Co. vs. Corbin, 64 Fed. Rep., 789, *Second Circuit.*

In **Marden Mfg. Co. vs. Campbell Co.**, 67 Fed. Rep., 809, the situation was identical with that at bar, and was heard on motion of defendant to dismiss the cross-appeal of complainant. The Court of Appeals for the First Circuit considered the statute, and the reasons for its enactment, fully, holding that the purpose was only to permit a defendant to obtain a speedy appeal when under injunction. It was also contended in that case

> "that so much of the decree below as adjudged certain claims invalid, or not infringed, was final and entitled the complainant to appeal, independently of the seventh section of the act of March 3, 1891."

The Court said:

> "On the contrary, the practice has been so continuous for so long a time the other way, and with such universal acquiescence, that this proposition, so far as we know, has never before been made, nor any necessity arisen for its adjudication."

In **Kilmer Manufacturing Co. vs. Griswold**, 67 Fed. Rep., 1017, decided April 23, 1895, two patents were sued upon.

The lower Court held one patent invalid and dismissed the bill as to it, and sustained the other patent and awarded an injunction and accounting thereunder. Both parties appealed from this "interlocutory decree." The Circuit Court of Appeals for the Second Circuit said:

> "Inasmuch as the decree of the Circuit Court is not final, the only appeal which can be con-

sidered is from so much of such decree as grants an injunction."

Apparently the defendant had not moved to dismiss the complainant's appeal; but the Court of its own motion refused to entertain or consider it.

In **Eagle Lock Co. vs. Corbin Cabinet Lock Co.**, 64 Fed. Rep., 789, the same situation was present and the same holding was made by the Court of Appeals for the Second Circuit. The Court said:

> "The circuit court for the district of Connecticut, upon 'final hearing' of the cause, dismissed the bill as to letters patent No. 285,916, and as to claim 1 of No. 337,187, and directed an injunction and an accounting as to the second claim of the later patent (52 Fed., 980). From that part of the interlocutory decree which related to the second claim, this appeal was taken by the defendant. As infringement is practically admitted, the validity of this claim is the only question before this court. The correctness of the other conclusions of the circuit court has not been considered, as the decree was not a final one."

Under the act as amended in 1900, the following decisions were rendered on exactly the same question and to the same effect.

National Co. vs. Automatic Co., 105 Fed. Rep., 670, *First Circuit.*
Thomson-Houston vs. Nassau Co., 112 Fed. Rep., 676, *Second Circuit.*
Western Elec. Co. vs. Abbott, 108 Fed. Rep., 953, *Sixth Circuit.*
Dowagiac vs. Superior Co., 115 Fed. Rep., 886, 890, *Sixth Circuit.*

In **National Co. vs. Automatic Co.**, 105 Fed. Rep., 670, there was an appeal by the complainant from so much of an interlocutory decree as refused an injunction. The Court of Appeals for the First Cir-

cuit dismissed the appeal on the ground of lack of jurisdiction.

In **Thomson-Houston Co. vs. Nassau Co.,** 112 Fed. Rep., 676, the Court of Appeals for the Second Circuit dismissed such a cross-appeal by the complainant. It appears from the decision in the Circuit Court, reported at 110 Fed. Rep., 647, 649, that the decree appealed from was an interlocutory decree holding six claims valid and infringed, five claims not infringed, and two other claims invalid.

In **Western Electric Co. vs. Abbott,** 108 Fed. Rep., 953, the decree

> "dismissed the bill as to the first claim of the patent as being merely for a function, sustained the other two claims,—2nd and 3rd,—and found that the defendant had infringed the same."

In this case the Court of Appeals for the Sixth Circuit overruled the contention that the amendment of 1900 did not operate to repeal the amendment of 1895, and also overruled the contention

> "that, as the decree finally disposes of the first claim of the patent, an appeal would lie independently of the statute,"

saying,

> "But as that part of the decree *did not finally dispose of the whole case*, which was retained for the purpose of an accounting upon the claims held valid, the right to appeal from the dismissal of the bill as to the first claim would be suspended until the final decree, when that action and any other which might be prejudicial could be brought up on one appeal. The other course would sanction the bringing up of a case 'piecemeal.' In thus holding we are in agreement with the opinion of the Circuit Court of Appeals for the First Circuit in Marden vs. Printing Press Co., 15 C. C. A., 26; 33 U. S. App., 123, 67 Fed., 809."

Cases construing the statute in the same way, but relating specifically to appeals from interlocutory orders rather than decrees are

Westinghouse vs. Christensen, 104 Fed. Rep., 622, *Second Circuit.*

Wire Co. vs Boyce, 104 Fed. Rep., 172, *Seventh Circuit.*

Frye & Bruhn vs. Carstens, 130 Fed. Rep., 766, *Ninth Circuit.*

A case holding that where an appeal from an interlocutory decree under the act as amended in 1895 was properly before the Court, and it was decided that the injunction was properly granted, the Court was not called upon to decide whether under the peculiar circumstances of the case, an accounting should have been denied, is

Metallic Extraction Co. vs. Brown, 104 Fed. Rep., 345, 354, *Eighth Circuit.*

The only case in which such a cross-appeal as that now before the Court has been entertained by a Court of Appeals, is

Chicago Co. vs. Miller Co., 133 Fed. Rep., 541, *Seventh Circuit.*

It is said by the petitioners that in the Fourth Circuit, the same conclusion was reached in

Scriven vs. North, 134 Fed. Rep., 366, *Fourth Circuit.*

This, however, is an error. The latter case allowed an appeal, independently of Sec. 7, because the decree was stated to be unusual and within the doctrine of *Forgay vs. Conrad*, 6 How., 201. The reasoning of the Court in the Scriven case is opposed to the petitioners' position here.

Thus, the Courts of Appeals of the First, Second and Sixth Circuits, have uniformly adopted the construction we contend for. In the Eighth Circuit, though the exact question has not been considered, a

conclusion was reached which necessarily meant that the Court had adopted the same construction. As against these, the only conflicting decision is the *Chicago vs. Miller* case, *supra*, in the Seventh Circuit.

There has been a line of decisions relating to the construction of Section 7, but involving the consideration of an entirely distinct question, namely, whether upon the defendant's appeal from an interlocutory order or decree granting an injunction the Court had power to set aside the accounting and dismiss the bill. The principal decisions on this particular question are *Smith vs. Vulcan Iron Works*, 165 U. S., 518, and the cases cited therein including *Richmond vs. Atwood*, 52 Fed. Rep., 10, and *Bissell Carpet Sweeper Co. vs. Goshen Co.*, 72 Fed. Rep., 545. We will discuss these cases hereafter, but we desire to call the attention of the Court at this time to the fact that they do not consider or in any way relate to the question whether or not a complainant is entitled to a cross-appeal from the parts of an interlocutory decree dismissing the bill.

We submit that the decisions of the Courts of Appeals for the four circuits mentioned above, holding that a complainant is not entitled to such cross-appeal, are entitled to great weight. The array of authority is unusually strong. We submit further that their construction of the statute is the only reasonable and logical one.

It is well known that Section 7 was inserted in the Judiciary Act in order to protect defendants upon whom an improvidently granted injunction operated, during the long period that might intervene between the entry of the interlocutory decree and the termination of the suit with a final decree. Defendants could be ruined by such an injunction, though ultimately prevailing, and no adequate remedy existed. In *Barnard vs. Gibson*, 7 How., 650, 658, this Court discussed this hardship and, with reference to patent

cases, stated that the usual practice should be for the Circuit Court to suspend the injunction pending the coming in of the master's report. However, in most circuits this method was followed only in exceptional cases rather than as the general rule of practice.

Section 7, therefore, enlarged the right of appeal by giving an appeal from "interlocutory orders or decrees" granting or continuing an injunction. Clearly the only party who may appeal is the party that is prejudiced by the granting or continuing of the injunction, the party that has been put under the drastic operation of an injunction thereby. It would be to read the Act ultra-literally and apart from its obvious purpose and intent to assume that it intended to allow either party to appeal from *any finding* set out in the order or decree merely because some part of that decree granted or continued an injunction.

The purpose of the 7th section of the Act of 1891 is very well expressed in the case of **Richmond vs. Atwood**, 52 Fed. Rep., 10, 28, where the Court says:

> "As already said, we think the term was used in its broadest sense, and, in our opinion, full scope should be given to this provision of the statute, to the end that any party aggrieved by any order or decree granting an injunction, at any stage of the proceedings, may have a speedy remedy by appeal. It is plain that the policy intended to be emphasized by this statutory exception to the general provision of the statute and the rule of law, limiting the right of appeal to final decision, is this: That, as injunction orders deprive parties of the possession and control of property and business, and, in case of error, work irreparable mischief and great injustice, *the party upon whom the order operates* should have an early opportunity to have the record examined by the appellate court, and, if error is discovered, to have it corrected without the delay necessarily incident to litigation in its various stages before reaching final judgment."

The appeal allowed by section 7 is specifically limited to an interlocutory order or decree "granting or continuing" an injunction or appointing a receiver. What is the meaning of this limitation? It can only mean that Congress did not intend to extend the right of appeal to interlocutory orders or decrees generally, and was not seeking to give any remedy or relief to a complainant under this section, but was extending relief only to a party who was under injunction and whose property interests were thus threatened with destruction. The only ground for including interlocutory decrees granting or continuing an injunction or appointing a receiver, and excluding all interlocutory decrees of other kinds, would be because Congress was of the opinion that the issuance of an injunction or the appointment of a receiver was a peculiar hardship or injury calling for the right of immediate appeal, whereas the other provisions of an interlocutory decree, such as those dismissing the bill as to some of the claims of a patent, did not create such a condition of hardship or injury as to require in justice an appeal at that stage of the cause. The petitioners admit in their brief filed with the petition, that the complainants would have no right of appeal of their own initiative. They say (p. 8 of Brief for Petitioners):

> "Petitioners may well concede that they cannot on their own initiative create the status on which depends the jurisdiction referred to. It might, indeed, violate established precedent to permit complainants, by appealing independently and in the first instance, from unacceptable parts of an interlocutory decree 'to try the case piecemeal.'"

The petitioners therefore admit that it was not the purpose of Congress, and it is not the meaning of this section, that any independent and unconditional right of appeal is conferred upon the complainants. They claim that the complainants have the right of appeal because the defendant first appealed. We submit that there is nothing conditional about the language of

Section 7. Whatever right of appeal it confers upon either party must be absolute and independent of the right of appeal of the other party or the action of the other party. This admission or concession of the petitioners is fatal to their contention that the complainants have a right of appeal under this section.

It is important to note that the act places "orders" and "decrees" on the same footing, so that the construction to be given to the act must be one having equal application to both. The distinction between an "interlocutory order" and an "interlocutory decree" is well understood, and Congress must be presumed to have understood the distinction (*Bissell vs. Goschen*, 72 Fed. Rep., 545). It will hardly be contended by the petitioners, we think, that where an interlocutory order granting an injunction also granted other temporary relief, or directed other things to be done of a preliminary and temporary nature, the complainant would have the right of appealing from all of the other parts of such interlocutory order. Yet if the petitioners' contention as to the meaning of this section is correct, the complainant would be entitled to such an appeal from interlocutory orders just as much as from interlocutory decrees, for the statute makes no distinction between the two.

It is also important to note that Section 7 provides that the appeal "shall take precedence in the appellate court." Evidently precedence is given only because the defendant is under an improperly granted injunction, or because property has been put into the hands of a receiver, and proceedings are to be speeded manifestly in order that such injunction or receivership may be quickly removed or terminated if improper. This provision indicates clearly that this section was intended to give relief to the defendant and not to the complainant.

Again Section 7 provides that "an appeal may be taken," that is to say, one appeal and no more. This one appeal is the appeal of the defendant. This argu-

ment is enforced by a comparison of the language of Section 7 with the language of Section 6 of the same act, which provides for appeals by one or both parties from final decrees. Section 6 reads as follows:

> "SECTION 6. That the Circuit Court of Appeals, established by this Act, shall exercise appellate jurisdiction to review by appeal or by writ of error, final decisions in the district court and the existing circuit courts, &c."

The Court of Appeals is thus empowered "to review" "final decisions." This means the whole decree or decision, including the parts that are unfavorable to the complainant as well as those that are unfavorable to the defendant, and necessarily means that appeals may be taken by either party who is aggrieved.

Section 7, on the other hand, is sharply contrasted with this. It does not provide that the Court shall have power "to review" "interlocutory orders or decrees granting or continuing an injunction, &c.," but its language is strictly limited to the effect that "an appeal may be taken." This limitation to one appeal is consistent with the limitation to an order or decree granting or continuing an injunction or appointing a Receiver, and means that there is to be one appeal, and that by the defendant.

In short, the natural meaning of the act is that an appeal under Section 7 will lie only against the operation of an injunction or the appointment of a receiver, and it must be speedily determined, and that, meanwhile, all other proceedings in the suit continue in the Court below, unless otherwise ordered, unaffected by the pendency of the appeal taken from the granting of the injunction or the appointment of a receiver.

II.

In Smith vs. Vulcan Iron Works the present question did not arise. That case is not in conflict with the decisions of the Circuit Courts of Appeals denying the right of complainant to a cross-appeal. It considered only the extent of the relief that could be given to a defendant improperly enjoined.

The petitioners' argument rests almost wholly upon the decision of this Court in *Smith vs. Vulcan Iron Works*, 165 U. S., 518. It is important to consider the facts which were before the Court in this case, as it will be seen at once that the question whether a complainant had a right of appeal under Section 7 did not arise and was not involved either directly or indirectly.

Two cases were before the Court on petitions for writs of *certiorari*. In both cases an interlocutory decree had been entered by the Circuit Court adjudging that the patent was valid and had been infringed, and granting an injunction and an accounting. In both cases the decree was wholly favorable to the complainant. The only appeal taken was by the defendant. The complainant did not appeal and had no reason for appeal because he had obtained all the relief that he asked for and was in no way aggrieved.

The Court of Appeals, in order to determine whether the defendant had been properly enjoined under the patent, had to decide whether the claims of the patent were valid and had been infringed. In the first case the Court decided these questions in favor of the defendant, and directed not merely that the injunction should be set aside by the Circuit Court, but that the bill should be dismissed. In the second case the Court of Appeals upon re-hearing decided the question of

infringement in favor of the defendant, and in like manner directed the Circuit Court to dismiss the bill.

The complainants then filed their petitions in this court for writs of *certiorari*. These petitions raised the following question:

When the Court of Appeals has acquired jurisdiction, upon a defendant's appeal under Section 7, of the issues of validity and infringement of the claims of a patent, in order to determine the propriety of the injunction, and when it has determined either or both of these issues for the defendant, to what extent can it grant relief? Has it power only to set aside the injunction, or can it give the full relief which must necessarily follow at some time from its decision on validity and infringement, that is to say, can it dismiss the bill?

The question did not arise in either of these cases whether the Court could reach out for and take jurisdiction of other issues having no relation to the injunction granted by the lower Court, or of other parts of the decree not resulting from a determination of those issues, or whether the Court had jurisdiction to entertain an appeal by the complainant from other parts of the decree. **The question in Smith vs. Vulcan Iron Works was as to extent of remedy, not extent of jurisdiction.**

Certain language occurring in the opinion of the Court is relied upon by the petitioners in support of their proposition that the complainant has a right of appeal, but this language, when considered in connection with the question before the Court, affords no support for the petitioners' proposition. On the contrary, we submit that it is a necessary inference from the language used by the Court that the right of appeal rests in the defendant alone.

The petitioners also rely upon the decision of the Court of Appeals for the Seventh Circuit in *Chicago vs. Miller*, 133 Fed. Rep., 531, but as this latter decision is based wholly upon the case of *Smith vs. Vulcan Iron Works*, it follows that if no authority is found in

the latter case for the petitioners' contention, the case of *Chicago Co. vs. Miller* is without weight.

The principal argument of the petitioners and the principal basis of the decision of the Court of Appeals in Chicago Co. vs. Miller, 133 Fed. Rep., 541, is that under the doctrine of the case of Smith vs. Vulcan Iron Works, 165 U. S., 518, the taking of an appeal by defendant under the provisions of Section 7 of the Judiciary Act brings the decree and the record before the Appellate Court, and so gives the complainant the right to file a cross-appeal from such portions of the decree as found unfavorably to it. The petitioners admit that they would have no right to appeal under the terms of Section 7, except when defendant first appeals.

We do not understand that this Court has announced any such doctrine in Smith vs. Vulcan Iron Works, or that there is anything in that opinion from which such a doctrine can properly be deduced. We understand the doctrine of Smith vs. Vulcan Iron Works to be that where an appeal by defendant under Section 7 is properly before the Court, and the conclusion that the Court reaches as to the granting of the injunction, is such as to necessarily involve the dismissal of the bill, then further expense and delay in the litigation may be stopped by a mandate to the lower Court to enter a decree dismissing the bill. The doctrine of Smith vs. Vulcan Iron Works simply involves the idea that when the Appellate Court has been obliged on defendant's appeal to reach a certain definite conclusion on the issues raised by the appeal, then the decree that should necessarily follow that conclusion should be entered by the lower Court. The petitioners extend that doctrine to apply to a case where the Appellate Court would be obliged to consider *other issues* brought up on a separate appeal, and to adopt *additional conclusions*.

Our understanding of Smith vs. Vulcan Iron Works is in accord with the decisions of the Courts of Appeals of the First and Second Circuits on the very point now

at issue, made prior to the decision of Smith vs. Vulcan, and specifically approved in that opinion. The understanding of Smith vs. Vulcan Iron Works expressed by the petitioners is concededly in direct opposition to these cases that were cited with approval in Smith vs. Vulcan Iron Works. Prior to the latter decision, the question had arisen in many of the Circuits whether the Appellate Court, in reviewing a decision under Section 7 of the Judiciary Act, must limit its mandate to the reversal of that part of the decree ordering the injunction, or whether having found that the injunction should not issue because there was no equity in the bill, the mandate could order the entry of a decree dismissing the bill. While there had been some variance in the decisions of the different Circuits, yet all of the Circuits that had passed upon this point had finally reached the same conclusion—namely, that where an appeal had been taken from a decree granting an injunction, the Appellate Court should order such a decree as would be in accordance with the conclusion that had been reached upon the issues presented, dismissing the bill if it was without equity.

Mr. Justice GRAY, writing the opinion in Smith vs. Vulcan Iron Works, stated the questions presented in the following language :

> "The questions presented by each of these cases are whether, in a suit in equity for the infringement of a patent, an appeal to the circuit court of appeals from an interlocutory order or decree of the circuit court, granting an injunction, and referring the case to a master to take an account of damages and profits, may be from the whole order or decree, or must be restricted to that part of it which grants the injunction ; and whether the circuit court of appeals, upon such an appeal, may consider and decide the merits of the case, and, if it decides them in the defendant's favor, may order the bill to be dismissed."

Then after stating that there had been some diversity among the Circuit Courts of Appeals and referring to some of the earlier cases, the learned Justice said:

> "But in the first circuit, the power of the circuit court of appeals, upon such an appeal, to consider the merits of the case, and to order the bill to be dismissed, was maintained, after thorough discussion of the subject on principle and authority, in an opinion delivered by Judge ALDRICH Richmond v. Atwood [September, 1892], 5 U. S. App., 151.
>
> "This view has since prevailed, not only in the first circuit: Marden v. Campbell Printing Press & Mfg. Co. [May, 1895], 33 U. S. App., 123, &c.," (citing a long line of cases in different circuits).

He also cited the case of Kilmer Mfg. Co. vs. Griswold, 67 Fed. Rep., 107.

The position of the petitioners and the decision of the Court in the Seventh Circuit in Chicago Co. vs. Miller Co., are both based upon the ground that the decision of Smith vs. Vulcan Iron Works established principles that were opposed to the decisions of the Courts for the First and Second Circuits in the two cases above cited. Yet Mr. Justice GRAY cited them as being in accord with the principles he was enunciating for this Court.

In Richmond vs. Atwood, cited by Judge GRAY, the exact situation before the Court in Smith vs. Vulcan Iron Works was presented, and precisely the same finding was made. The case of Marden vs. Campbell, also cited by Judge GRAY, was *exclusively* directed to a discussion of the exact question now at issue and coupled its discussion with an explanation of the case of Richmond vs. Atwood, and a statement that it had been misunderstood, saying:

> "Under the circumstances of Richmond v. Atwood the injunction covers the entire case, and thus an appeal from the injunction brings up the

whole decree, and necessarily the whole record, *so that the court is required, for the mere purpose of adjudicating, touching the injunction, to examine on appeal the entire case;* and so no detriment to the court or the parties can come by its thereupon disposing of the merits, and entering orders to the circuit court analogous to those entered upon an appeal from a final decree. *This, however, is a very different thing from reaching out for parts of the record, and of the decree below, not covered by the injunction order.*"

Exactly as the case of Richmond vs. Atwood was misunderstood prior to the decision of Marden vs. Campbell, so has the decision of Smith vs. Vulcan Iron Works been misunderstood by the Court of Appeals for the Seventh Circuit and by the petitioners. In view, however, of the fact that in the decision of this Court the two cases of Richmond vs. Atwood and Marden vs. Campbell were cited together, we understand that this Court intended to indicate that it approved the decision in the Marden case.

But the language of Smith vs. Vulcan Iron Works is, we submit, entirely clear and unambiguous. The Court in the plainest terms defined the purpose of Sec. 7 of the Judiciary Act as follows :

"The *manifest intention of this provision*, read in the light of the previous practice in the courts of the United States, *contrasted* with the practice in courts of equity of the highest authority elsewhere, appears to this court to have been, not only to *permit the defendant to obtain immediate relief from an injunction*, the continuance of which throughout the progress of the cause might seriously affect his interests, but also to save both parties from the expense of further litigation, *should the appellate court be of opinion that the plaintiff was not entitled to an injunction because his bill had no equity to support it.*"

We submit that there is no warrant here for the contention that the appellate court may, under the provisions of Sec. 7, give a complainant an enlarged decree by taking jurisdiction of issues other than those involved in the granting of the injunction below. The petitioners' contention necessarily assumes that this Court failed to use sufficient perspicuity in the closing phrase of the quoted sentence, and really intended to say that the purpose of the act was not only to relieve the defendant from the effect of an improperly granted injunction,

> *but also to decide all matters that were at issue in the case below, and order a decree in conformity therewith.*

We believe we can safely assume that this Court meant exactly what was said, and that it advisedly employed the language it did in order that it should not be misunderstood as covering the situation now present, and present in *Marden vs. Campbell, supra.*

The case of *Chicago Co. vs. Miller Co.* is, we submit, one that shows a failure to grasp the whole situation and logically apply to the language of Sec. 7 the doctrine of Smith vs. Vulcan Iron Works and the settled principles and terms of our jurisprudence. It confuses the terms interlocutory *order* and interlocutory *decree*, and in effect says that the act, although treating interlocutory orders and decrees alike, confers wider jurisdiction in the case of interlocutory decrees than in the case of interlocutory orders. It also confuses interlocutory decrees and final decrees and seems to consider that if it can find an approach toward finality about the decree before it, it can apply Section 7 of the act more broadly than it otherwise could. It erroneously allowed an appeal to defendant on a patent that had expired and upon which an injunction had, therefore, not been allowed and seemed to think that the entertaining of this appeal would more or less justify the entertaining of complainant's cross-appeal.

Thus in *Chicago Co. vs. Miller* the Court says:

> "A decree of this character in a patent suit is customarily called interlocutory. If it were in truth final, as was the decree in the land suit of Forgay vs. Conrad, 6 How., 201; 12 L. Ed., 404, complainant's right to a cross-appeal could not be successfully questioned. If it were in truth interlocutory in the sense and to the extent that the decree awarding the temporary injunction was interlocutory, complainant's lack of right to a cross-appeal would be indisputable."

But the decree in *Forgay vs. Conrad* was said by this Court to be, strictly speaking, an interlocutory one. An appeal was allowed only because the decree ordered the actual delivery of property and awarded execution therefor. It was, therefore, considered final for the purpose of appeal. Yet, if the decree in *Chicago Co. vs. Miller Co.* were in truth final, or within the doctrine of *Forgay vs. Conrad*, complainant would not obtain a right of appeal under Sec. 7, but under Sec. 6. If the decree were interlocutory to the extent "that the decree awarding the temporary injunction was interlocutory," then it *would not be a decree*, but a mere interlocutory *order*. If, under these circumstances, "complainant's lack of right to a cross-appeal would be indisputable," then it must only be because complainant would have no right under Sec. 7 of the Judiciary Act. If complainant has no right under Sec. 7 to appeal from a portion of an interlocutory *order* to which it objects, then it must necessarily follow that it has no greater right to appeal from an interlocutory *decree*, for the Court has no right to presume that Congress, in employing the terms "interlocutory orders and decrees," intended to make a distinction between interlocutory orders and interlocutory decrees, because to do so would be to assume that Congress, though using both terms in the same way, intended to provide different rights of appeal therefrom.

The case of *Bissell vs. Goshen*, 72 Fed. Rep., 545, very clearly set out the well recognized distinctions between interlocutory orders and interlocutory decrees, and held that Congress must be presumed to have appreciated the distinction between them when including both within the provisions of Section 7 of the Judiciary Act.

Chicago Co. vs. Miller, in fact, states that from an interlocutory order granting an injunction the defendant only can appeal, whereas if it be an interlocutory decree the complainant may also appeal from that portion of the decree that denies an injunction. This means that by construction the Court has added a proviso to the act to make it distinguish between interlocutory orders and interlocutory decrees.

In making this distinction between interlocutory orders and interlocutory decrees, and applying the supposed doctrine of *Smith vs. Vulcan Iron Works* to interlocutory decrees only, the Court in *Chicago Co. vs. Miller* has also overlooked the fact that this Court has made no distinction in applying the doctrine of *Smith vs. Vulcan Iron Works* to interlocutory orders and interlocutory decrees.

In *Mast, Foos & Co. vs. Stover*, 177 U. S., 485, 495, this Court held that upon an appeal by a defendant from an order granting a *preliminary* injunction, the Appellate Court should dismiss the bill on the merits if it was clear that the bill was without equity. In so holding this Court referred to and directly applied the doctrine of *Smith vs. Vulcan*, the only distinction between the two cases being that where a preliminary injunction was appealed from, the Appellate Court, before dismissing the bill, would necessarily consider whether its conclusions might be altered by proofs. If the doctrine of *Smith vs. Vulcan* then means what the petitioners contend and what the Court in the *Chicago vs. Miller* case held, it necessarily follows that under Section 7 of the Judiciary Act the complainant may appeal and obtain an enlarged injunction from an interlocutory order granting a preliminary injunction.

Yet the Court in the *Chicago vs. Miller* case considered that from such an order "complainant's lack of right to cross-appeal would be indisputable."

Other cases in this court have also applied the doctrine of *Smith vs Vulcan Iron Works* to interlocutory orders as distinguished from interlocutory decrees. Thus, in *In re Tampa Suburban Railroad Co.*, 168 U. S., 583, this Court, citing the *Smith vs. Vulcan* case, states that where an order has been entered which appoints a receiver and grants an injunction "the appeal provided for may be taken, and carries up the entire order, and the case may, indeed, on occasion, be considered and decided on its merits."

This decision interpreted the act as amended in 1895, which did not provide for an appeal from an order appointing a receiver. It is clear, however, that in order to pass upon the right of the Circuit Court to grant the injunction, it was necessary to pass upon the question of the right of the Court to appoint the receiver. The sole issue was whether the receiver had been properly appointed; for, if he had been, the injunction was proper, and, if he had not been, the injunction was improper. Therefore, the doctrine of *Smith vs. Vulcan* was properly applied in the Tampa case and, as in the *Mast, Foos & Co.* case, it was applied to a mere order rather than a decree.

III.

The history of this legislation and of the times shows that it was the intention of Congress to give the right of appeal to the defendant but to deny it to the complainant.

It is well settled that the Court, in construing a statute, will endeavor to carry out the intention of the

Congress, and will consider the circumstances which led to the passing of the statute, and the history of the statute; and that the object which the Congress sought to attain and the evil which it was endeavoring to remedy may always be considered for the purpose of ascertaining its intention (*Durland vs. U. S.*, 161 U. S., 306, 313; 16 Sup. Ct., 508; 40 L. Ed., 709; *Platt vs. Union Pac. R. Co.*, 99 U. S., 48, 59; 25 L. Ed., 424; *Koh'saat vs. Murphy*, 96 U. S., 153, 160; *Heydenfeldt vs. Gold & Silver Min. Co.*, 93 U. S., 634, 638; *Brown vs. Duchesne County*, 60 U. S., 183, 194; 15 L. Ed., 595; *Blake vs. Banks*, 23 Wall., 307, 319; *U. S. vs. Freeman*, 3 How., 556, 565; *Wilkinson vs. Leland*, 2 Pet., 627, 662; *U. S. vs. Wiltberger*, 5 Wheat., 76, 95; *Brown vs. Barry*, 3 Dall., 365, 367.

It seems too clear to require argument or authority that the effect and purpose of the amendment of February 18, 1895, making the statute read that an appeal may be taken where "an injunction shall be granted, continued, refused or dissolved by an interlocutory order or decree," etc., was to confer a right of appeal upon the complainant; and that when those words were omitted in the amendment of June 6, 1900, and the original phrase, "where * * * an injunction shall be granted or continued by an interlocutory order or decree" was substituted, the effect and purpose was to take from the complainant the right of appeal conferred by the amendment of February 18, 1895.

The Court in the isolated case of *Chicago Co. vs. Miller Co.* 133 Fed., 541, 544, relied upon by the petitioners, said that under the present amended act in case of a decree awarding a temporary injunction "the complainant's lack of right to a cross-appeal would be indisputable." This was said in face of the fact that the act provides separately and distinctly for the two classes of decrees, final and interlocutory, and in the face of or in ignorance of the fact that precisely the kind of decree which the Court mistakenly supposed had been rendered by the Circuit Court in that case had been re-

peatedly held by the Supreme Court of the United States to be an interlocutory decree.

It must be assumed that the Congress was aware of the long line of decisions distinguishing between "final" and "interlocutory" and "orders" and "decrees;" and there is no warrant either in the words of the act or in the history of the act for any other conclusion.

The history of the act, and particularly the history of the amendments and the attempted amendments, shows that the almost uniform interpretation of the act as conferring a right of appeal upon the defendant only is in accordance with the clearly expressed intention of the Congress.

The Judiciary Act, or the Evarts Act, of 1891, in addition to creating the Circuit Courts of Appeal, provided, amongst other remedies, for an appeal by a party enjoined, or as Mr. Evarts put it in the debate ensuing his report it provided for "*allowing an appeal in equity causes from injunction*" (C. R., 51st 1st sess., p. 10222).

The Act of 1891 had its origin in a bill introduced and later reported by Mr. Rogers, H. R. 9014. This bill, afterwards presented to the Senate, was reported by Mr. Evarts with amendments, that is, the whole bill was stricken out and a substitute bill submitted. So far as the purposes of this discussion are concerned, the substitute bill was the same as the present law.

In the original House Bill, as reported by Mr. Rogers, Sec. 5 covered appeals generally. This section provided for an appeal to the Circuit Court, which was thus made an Appellate Court,—

> "Where upon a hearing in equity in a District Court, an injunction shall be granted or continued by an interlocutory order or decree in a case in which an appeal from a final decree may be taken."

Later in the same section and on the same page of the original bill, occurs the following:

> "Upon such writ of error or appeal, the Circuit Court shall review such order or judgment or de-

> cree and may affirm, modify or reverse the same, or may make such order, or may render such judgment or such decree as the District Court should have made or rendered, or may order a new trial or other proceedings therein."

Contrasting this with the terms of the law, as finally enacted, it will be observed that Sec. 6 of the Act provides for a "review" of the final decisions of the lower Court. Sec. 7 provides only that "*an appeal may be taken* from such interlocutory order or decree granting or continuing such injunction."

The rejection by the Congress of the Rogers House bill and the substitution therefor of the limited language of the Evarts Act, above quoted, could have had no other purpose than to limit the right of appeal to a defendant under injunction.

In *Buttfield vs. Stranahan*, 192 U. S., 468, this Court, in construing an Act of March 2, 1897, considered the bill as originally presented in the House, and the amendments thereafter made in the Senate, quoting with approval the following language from the decision of the Court of Appeals for the Second Circuit on the same subject.

> "As originally introduced in the House, the bill prohibited the importation of 'any merchandise as tea which is inferior in purity or fitness for consumption to the standards provided in § 3 of this act.' It was amended in the Senate by inserting the word 'quality' between the words 'purity' and 'fitness for consumption' wherever they occurred in the House bill. The amendment evinces the intention of the Senate to authorize the adoption of uniform standards by the Secretary of the Treasury which would be adequate to exclude the lowest grades of tea, whether demonstrably of inferior quality, or unfit for consumption, or presumably or possibly so because of their inferior quality. The House concurred in the amendment, and the measure was enacted in its present terms."

Even in ordinary instances proposed amendments and reports thereupon are proper sources of information in the construction of a statute. In this instance the character of the amendments make them of peculiar significance *(Church of Holy Trinity vs. U. S.*, 143 U. S., 457; *Buttfield vs. Stranahan*, 192 U. S., 470).

The debates on the original bills, which eventuated in the law, appear in the Congressional Record as follows:

51st Congress, First Session. Pages 3298, 10193, 10199, 10217, 10278, 10302, 10335, 10363.

Second Session. Pages 2198, 3087, 3535, 3583.

These debates are not referred to as in all instances offering sources of information for the interpretation of the law, but as evidencing the unusually careful attention given this bill in both Houses of Congress and by the Judiciary Committees and the distinguished gentlemen who reported these bills.

The Judiciary Committees of Congress, as the reports indicate, considered these bills as a quasi-judicial tribunal; and the great learning and distinguished reputation of Mr. Evarts make it impossible to premise anything but intention in the sharp differentiation of the phrases of sections 6 and 7 of the Act so carefully studied and revised by him.

This Act has been the subject of many proposed amendments, most of them turning upon the suggestion of inserting or omitting the phrase found in the amendment of 1895, "refusing, diss lving or refusing to dissolve" and upon the appointment of receivers and the granting of an appeal from a refusal to appoint a receiver.

It has been heretofore observed that the phrase, "refusing, dissolving or refusing to dissolve an injunction," was added to the statute in February, 1895, and was subsequently omitted from the statute when the amendment respecting the appointment of receivers was made on June 6, 1900. Since 1900, at practically every session of the Congress, an attempt has been made to again insert into the statute the phrase, "re-

fusing, dissolving or refusing to dissolve an injunction." The reports of the distinguished Chairmen of the Committees on Judiciary of House and Senate disclose the precise intention of the Congress respecting the rights of the complainants and defendants in taking appeals under this Act. Nothing could be more explicit and direct, for example, than the report of Mr. Overstreet to accompany H. R. 13,843, Report No. 2849, Fifty-sixth Congress, Second Session, the session immediately following that in which the amendment of June 6, 1900, had been adopted, taking from the law the phrase conferring a right of appeal upon a complainant. In that report the chairman said :

> " The act creating United States Circuit Courts of Appeals was approved March 3, 1891 (U. S. Stat. L., vol. 26, p. 828). Section 7 relates to appeals from interlocutory orders or decrees. It gives an appeal from such an order or decree granting or continuing an injunction, but none from an order refusing or dissolving an injunction. The effect is to allow an appeal in such cases to the defendant, but none to the plaintiff.
>
> " Section 7 was amended by act approved February 18, 1895 (U. S. Stat. L., vol. 28, p. 666), so as to provide that an appeal should be from an order granting, continuing, refusing, dissolving, or refusing to dissolve an injunction, thus putting the plaintiff and defendant on an equality with respect to the right of appeal."

This same report was repeated in Report No. 186 on H. R., 109, 57th Congress, First Session.

Mr. Fairbanks from the Senate Committee on Judiciary, submitted report No. 2206 to accompany S. 5732 in 56th Congress, Second Session. He said :

> " The original act (circuit court of appeals act, March 3, 1891, I Supp. Rev. Stat., p. 904) provided for an appeal from an interlocutory order or decree *granting or continuing* an injunction, etc.
>
> " The first amendment (February 18, 1895, II. Supp. Rev. Stat., p. 376) provided that ' an appeal

may be taken from such interlocutory order or decree *granting, continuing, refusing, dissolving, or refusing to dissolve an injunction,*' etc. The bill (H. R. 5216) was introduced in the House by Mr. Draper and reported to the Senate by Mr. Hoar, with an amendment providing for an additional bond.

The second amendment (June 6, 1900, H. R., 4915) provided for an appeal in cases where a receiver has been appointed. But it amended the original section instead of the amended one, and repealed (unintentionally, it has been suggested) the first amendment. It should be mentioned, however, that the bill (S. 3685) reported April 9, 1900, and now on the Senate Calendar, contained a clause 'that where * * * an injunction shall be granted, continued, *refused or dissolved;*' * * * and the words 'refused or dissolved' were stricken out by the committee.

The House bill (H. R., 4915) agreeing with the Senate bill, thus amended, was passed by the Senate June 6, 1900.

The third amendment to the present bill (S. 5732) seeks to restore the provisions of the first amendment (February 18, 1895) giving an appeal to the plaintiff in an injunction case, and retaining the provision of the second amendment (June 6, 1900) (H. R., 4915) giving appeals in receivership cases.

In brief, the purpose of the pending bill is to give the right of appeal from all interlocutory orders relating to injunctions or receiverships equally to the plaintiff and defendant.

The committee is of the opinion that either party should have the right of appeal from such orders, and recommend that the bill do pass."

The debate in the House on this point will be found in the Congressional Record, 56th, 2d Session (pp. 3227-9). In the opening of the debate Mr. Overstreet,

the Chairman of the Judiciary Committee, replying to a question, said:

"It has been considered by the Judiciary Committee and comes before the House with practically a unanimous report. The gentleman from Missouri (Mr. De Armond) reserved the right to object; but no minority report has been filed. It is a lawyers' bill for the purpose of granting a right of appeal to either the plaintiff or the defendant in both injunction and receivership proceedings."

Later in the discussion the objections to the bill were pointedly expressed and answered as follows:

"Mr. De Armond: Well, I do not know whether it would have especially that effect, but it would have the effect of permitting a person to appeal when an appeal is not necessary for his protection but prejudicial to his adversary, where, though he give bond, the liability can be only nominal and theoretical. This bill will give the effect of an order or decree, though such order or decree be denied, and an affirmance by the higher court will entail no responsibility for substantial damages, however great in fact the damages may be. At least that is my opinion, and for these reasons I am opposed to the bill.

"Mr. Overstreet: Mr. Speaker, this bill has received the endorsement of the National Bar Association. It merely seeks to place the plaintiff and the defendant upon an equality in matters of appeal. There is no additional power granted the circuit or district courts, and the same method of procedure in appeals will obtain in this particular as obtains at present in other cases. Proper safeguards are provided in the measure requiring additional bonds, and there is nothing further involved than the privilege of appeal to either party upon meeting the requirements of the court in the matter of the bond."

This bill, like others of the same import, passed the House (*e. g.*, C. R., 56th, 2nd, p. 3234; 57th, 1st, p. 1706; 58th, 3rd, p. 2412) only to be defeated in the Senate.

The debate in the Senate in 56th, 2d session, is found particularly at pages 2651-2, C. R., and is significant in that it briefly states the intentions of the Judiciary Committee and the authors of the bill and the opposition to the bill by an influential member of the sub-committee of the Senate Judiciary Committee.

"MR. FAIRBANKS: It changes it by giving to the plaintiff the right of appeal from an order refusing an injunction.

"The act creating the United States circuit courts of appeal authorized an appeal from an interlocutory order or decree granting or continuing an injunction, but not from an order refusing or dissolving an injunction. This act was amended February 18, 1895, so that an appeal would lie from such interlocutory order or decree granting, continuing, refusing, dissolving or refusing to dissolve an injunction. Both the plaintiff and defendant are thus put upon an equal footing as respects the right of appeal.

"The act was again amended June 6, 1900. This amendment provided for an appeal in cases where a receiver is appointed. It amended the original act instead of the first amendment, and repealed the latter.

"The pending amendment simply restores the provisions of the first amendment, giving an appeal to the plaintiff in an injunction case and retaining the provision of the second amendment giving appeals in receivership cases.

"The bill seeks to place the plaintiff and defendant in injunction and receivership cases on an absolute equality as respects the right of appeal.

"There is a strong and urgent demand from the bar for the passage of this bill.

"MR. TELLER: Mr. President, until 1895 it had

never been the practice that an appeal would lie from a refusal to grant an injunction. That got into the statutes in some way, and later on it got out, and this is a proposition to restore it.

"I do not want to object to the consideration of the bill, but I want to enter my protest against it. I did not agree to it in the committee and I do not agree to it now. It is a vicious thing to allow an appeal from a mere refusal to grant an injunction. It enables parties who have really no claim to go before court and ask for an injunction, and when the court says: 'No; you have no case,' they can by such an appeal tie up the property and get into litigation. It opens the door for blackmailing, and particularly in the Western country; for instance, in the case of a mining claim or something of that kind. It is vicious, but I do not want to object to the consideration of the bill, because a majority of the committee reported it. I want to say, though, it is not a good bill, and it ought not become a law.

"MR. THURSTON: Mr. President, permit me to state that this is a bill which was brought to the attention of Congress through the American Bar Association, and the bill was drafted by that association. The necessity for it has been very apparent to the bar of the country. They were so much interested in it that they sent here a committee of leading lawyers, who appeared before the Judiciary Committee and presented it to our consideration."

The debate in this instance was between gentlemen of great reputation and of large experience. As the record shows, Messrs. Fairbanks and Teller were in fact members of a sub-committee having this matter in charge. It thus appears that the Senate Committee on Judiciary and the Senate had under consideration a proposition to insert into the present law that

phrase, taken from the amendment of February 18, 1895, which was intended by the Congress to give the complainant a right of appeal, and that this clause, though favorably reported by the Senate Committee on Judiciary, and later passed by the House, was so vigorously and successfully opposed by influential members that the Senate refused to so amend the law, and has continued to refuse to so amend with each succeeding Congress. The situation, therefore, is unusually clear in this matter. A specific phrase was added to Section 7 of the original act for the very purpose of giving a right of appeal to the complainant. That clause, in a subsequent amendment, was omitted from the law, and the Congress has specifically and repeatedly refused to replace the phrase and give the right of appeal to the complainant, a right that is now suggested may be given by the Court in the face of the direct prohibition of the Congress.

There can be no question of the intent of the Congress by Section 7 of the original act to give to the defendant enjoined a right of appeal from either an interlocutory order or an interlocutory decree. *That intention should be made effective by the Courts.*

There can, on the other hand, be no question of the intent of the Congress by and since the amendment of June 6, 1900, bringing the act back to its original form, to deny to the complainant the right of appeal. *That intention should be made effective by the Courts.*

The first intention of the Congress was remedial. To make it effective it was, in some patent suits, necessary to consider the merits of the cause so that it might be determined if the defendant had been rightly enjoined.

The second intention of the Congress was the denial of a remedy. To make that denial effective is it required that the Courts shall hear the appeal of the complainants or go one step beyond deciding whether or not the defendant was rightly enjoined and whether

or not the bill should be dismissed to the extent to which the injunction is based upon it ?

Where a law was intended to provide a remedy for one of the parties, but not for the other, it should not be construed so as to give the remedy where it was intentionally denied.

The petitioners contend that the effect (if not the intention) of Section 7 is to introduce the practice in equity as formerly administered in the Court of Chancery in England and in the State of New York and in the House of Lords. It is a complete answer to this suggestion that Congress refused to adopt this practice of giving the right of appeal generally to either party from interlocutory orders or decrees, and strictly limited the right of appeal to certain special cases where peculiar hardships resulted to a defendant. Nothing appears more plainly from the language of the act, and from the history of the legislation and the times, than that Congress was careful to adhere in the main to the practice which had been established in our judicial system for a century, and to modify it only in a most limited manner.

IV.

The argument of "convenience" advanced by the petitioners is wide of the mark. The question in issue is the construction of a statute.

But even the argument of convenience does not support the contention of the petitioners.

We will first consider this point with reference to patent suits. In the very case upon which the pro-

ceedings rest the patent includes two classes of claims —process claims and claims for an article of manufacture. All of one class, the process claims, 9–12, were held not infringed. The petitioners are endeavoring to have the defendant and the Court consider now these distinct claims as well as those for the article of manufacture.

It not infrequently happens that a patent in litigation involves a simple article of manufacture and a difficult process, or a process involving difficult scientific or mechanical questions. In such a case a defendant enjoined from selling the article, but not infringing the process, might have the injunction promptly dissolved upon a mere comparison of the articles by the appellate court, without being obliged to endure the long delay involved in a consideration of the whole patent.

Would it have served the convenience of any one not interested in oppression to have had all four of the separate features of *Scriven vs. North, supra*, brought up by the appeal of the defendant if he had been enjoined merely upon some of the claims of the patent?

In *Union Signal & Switch Co. et al. vs. The Phila. & Reading R. R. Co.*, 87 Fed., 906, and 96 Fed., 761, a series of five patents, some of them involving a complicated system of electric railway signaling, were before the court. One patent was for a simple and minor improvement for electrically connecting two adjoining rails. If the defendant had appealed from an injunction relating to this minor improvement alone, would it have been "convenient" to have pressed upon the parties and the court a consideration of all the other complicated inventions?

In a case of "double patenting" with the broad claim in the second patent, if the defendant were enjoined upon the broad claim, and not upon the narrow claims of the first patent, would it be "convenient" to consider all the questions if the defendant should base an appeal upon the abandonment in law of the broad claim?

In a reissue case where the patent included the narrow claims of the original and a broadened claim of the reissue would it be "convenient" to consider all the questions of patentable novelty of all the claims if the defendant should base an appeal from an injunction relating to the broad claim upon the doctrine of *Miller vs. Bridgeport Brass Co.?*

It may often happen, as in the recent case of *Marlin Firearms Co. vs. Kellogg*, 139 Fed., 31, that the defendant is enjoined from using some separate feature of a complicated structure, a feature, however, so placed in the mechanism that it might require an entire reorganization of the mechanism to omit it. Would it be just or "convenient" if, in the absence of a specific provision of the statute, the defendant should be delayed in having the injunction dissolved by the necessity of considering all the difficult and distinct questions involved in the other claims?

In the much quoted case of *Sessions vs. Romadka*, 21 Fed., 124, the patent included four different articles of general applicability applied to different parts of a trunk. The consideration of one did not involve a study of the others. If the defendant had been enjoined (as he was) on any one it would have been a hardship, not a "convenience", to have discussed all, in order to reach a conclusion upon one.

We have not attempted, in this brief statement of what appears to be an irrelevant feature of the discussion, to in any degree catalogue the classes of patent causes in which the practice contended for by the petitioners would result in placing an unnecessary burden upon the Court and a hardship upon the defendant, whom the statute was intended to relieve. While in some patent cases it might be convenient for the Court to entertain such cross-appeal, in equity suits generally it might often result in great hardship and burden upon the Court and the parties to permit such a cross-appeal simply because an injunction is granted in some formal or trifling matter by some portion of the decree.

For example, where a court of equity has once obtained jurisdiction of a cause of action, injunctions are sometimes issued to prevent a party to the suit from bringing an action at law, or from bringing a suit in equity in any other court. In such case the injunction, if granted in an interlocutory order, would frequently be continued in the interlocutory decree. This injunction would often be a purely formal matter, not depriving either party of any property rights, but simply preventing one party from persecuting or harrassing the other by unnecessary litigation. The injunction might be such as a court of equity would grant as a matter of course, and as to the propriety of which there could be no substantial question. The other parts of the interlocutory decree might direct long and complicated accounts or further judicial determination on the part of a master or referee, so that an appeal from such other parts of the interlocutory decree at this stage would be unjustifiable or even absurd. Yet the mere presence in this decree of the clause granting the formal injunction would give the parties, one or both of them, the right to bring the entire interlocutory decree up on appeal, while the very same interlocutory decree in another case, if it did not happen to contain this formal provision for an injunction, could not be appealed from.

The intention of Congress in passing Section 7 was two-fold; first, to give a defendant under injunction the right of appeal; and, second, to give him the right or opportunity to have a speedy determination of such appeal. The construction contended for by complainants would defeat this second purpose of Congress.

V.

If the language of the statute is ambiguous, it will be strictly construed against any right of appeal in the complainants (1) because the original Statute of 1891 was uniformly construed in this way, and Congress must be held to have adopted this construction by re-enacting that law without change; (2) because the contemporaneous construction was against such right of appeal; (3) because the construction contended for by the petitioners would reverse a long established practice and system, and would result in absurdity; and (4) because the intent of Congress is unmistakable and must control, even if it were against the literal meaning of the statute.

1. It is a well settled principle of statutory construction that where an act receives a certain interpretation from the courts, and is then modified or repealed, and is afterward re-enacted in the same or substantially the same language that was used in the original act, the statute as re-enacted will be given the same construction that was put upon the original act. The reason for this is obvious. Congress is presumed to have known and to have taken into consideration the construction put upon the original act by the courts. If Congress, with such knowledge, again uses the same language, it must necessarily be because Congress intends that the re-enacted law shall bear the same construction. Otherwise Congress would certainly have changed the language of the act.

In *Sessions vs. Romadka*, 145 U. S., 30, 42, this Court was called upon to construe Sections 4917 and 4922 of the Revised Statutes. The Court said :

"Congress, having in the Revised Statutes, adopted the language used in the Act of 1837, must be considered to have adopted also the construction given by this Court to this sentence, and made it a part of the enactment."

See *In re* Guggenheim Smelting Co., 121 Fed. Rep., 153, 161.

"In the interpretation of re-enacted statutes the Courts will follow the construction which they received when previously in force. The legislature will be presumed to know the effect which such statutes originally had, and by re-enactment to intend that they should again have the same effect."

Sutherland on Statutory Construction (2d Ed.), § 403, p. 780.

We submit that this rule of construction, resting upon sound reason and authoritatively declared by this Court, is determinative of the present case. The Act of 1891, as we have shown, was uniformly construed by the courts to mean that the complainant had no right of cross-appeal. The amendment of 1895 broadened the right of appeal by giving to complainant an appeal from certain kinds of interlocutory orders or decrees. The amendment of 1900 did away with this broader right of appeal and returned to the language of the original act, adding only the provision relating to receivers. Under these circumstances the re-enacted law of 1900 must carry the same construction as that given to the original act.

2. It is a well-recognized principle of statutory construction that the contemporaneous construction of a statute will, in a case of doubt or ambiguity, be given great weight.

In *Hahn vs. United States*, 107 U. S., 402, the question arose as to the meaning of an Act passed by Congress in 1867 and repealed in 1874. The Act had been

construed in a certain way by the Government during these seven years and Congress had not interfered with such construction.

The Court of Claims held that such contemporaneous construction of the statute should be adopted and followed if possible.

This Court affirmed the decision of the Court of Claims and approved of its reasoning, saying:

> "The court added that such construction did not appear to it unreasonable and might well have been reached in the exercise of a sound judgment, and that, regarding the statute as ambiguous, all of the circumstances of the case were such as to justify the application of the principle of interpretation sanctioned by this court in *U. S. v. Pugh*, 99 U. S., 265 [XXV., 322], that, 'In the case of a doubtful and ambiguous law, the contemporaneous construction of those who have been called upon to carry it into effect is entitled to great respect. *Edwards v. Darby*, 12 Wheat., 210,' and where this court refused to interfere with such construction after it had been acted upon for a long time. See, also, *U. S. v. Alexander*, 12 Wall., 177 [79 U. S., XX., 381]; *Peabody v. Stark*, 16 Wall., 240 [83 U. S., XXI., 311]; *Smythe v. Fiske*, 23 Wall., 382 [90 U. S., XXIII., 49]; *U. S. v. Moore*, 95 U. S., 763 [XXIV., 589].

We submit that the same considerations apply to a case where a law has been construed by the judicial department of the government as to a case where the construction has been given by the executive officers. This is especially true where the act relates to questions of procedure or to the general system or method of administering justice. If the contemporaneous construction adopted by the Courts had been contrary to the intention of Congress, Congress could easily have amended the law so as to correct the error. The fact that Congress has not amended the law but has, on

the contrary, re-enacted it, is conclusive evidence that the contemporaneous construction of the Courts was correct.

See, also, *Pennoyer vs. McConnaughy*, 140 U. S., 23; *Price vs. Lancaster Co.*, 189 Pa. St., 95, 98; *Fisk vs. Henarie*, 142 U. S., 459; *Packard vs. Richardson*, 17 Mass., 121, 143.

As the contemporaneous construction of the act of 1891 was uniformly to the effect that the complainant had no right of appeal, such construction should prevail, in accordance with the principles laid down in the above authorities.

3. It is a well-established rule of statutory construction that where a statute changes or amends a long-established practice, or a system that has been in existence for a long time, the statute will be strictly construed and held not to introduce any greater change than necessarily follows from its language, and this is especially true where a more liberal construction would result in an absurd modification of the system.

It has been a recognized feature of our judicial system not to allow appeals from interlocutory orders or decrees. When Congress departed from this practice in Section 7 of the act of 1891, it strictly limited the right of appeal to interlocutory orders or decrees granting or continuing an injunction. The narrow way in which this exception was drawn strongly emphasized the fact that Congress still favored the policy which had prevailed from the foundation of the government as to appeals, and intended to modify it only in this limited way. In 1895 the right of appeal was extended to orders or decrees refusing or dissolving an injunction. But in 1900, Congress manifestly concluded that the general system that had previously prevailed had been departed from too far, and re-enacted the law in its original form. It is a significant fact that even in the broader act of 1895 the complainant was not given a general right of appeal from inter-

locutory orders or decrees. The right so conferred upon complainant was specifically limited to interlocutory orders or decrees refusing or dissolving an injunction. Underlying all of these special provisions there is the fundamental fact that Congress did not intend to establish appeals generally from interlocutory orders or decrees. Inasmuch as it has been the general theory or policy of the law not to grant such appeals, it would seem reasonable and in accordance with sound principle to strictly construe any statute amending the law in this regard. It is safe to assume that whatever exception to the general policy of the law Congress intended to establish would have been specifically and clearly set out in the act. It cannot be presumed that Congress intended to confer any right of appeal which is not clearly and specifically set forth.

Sutherland on Statutory Construction (2d ed.) Sec. 581, page 1072, states the law in this way;

> "But after the statutory system or policy has been long established and is well defined, it will not be lightly presumed to be departed from or abandoned."

The construction contended for by the petitioners would introduce an absurdity into the law. Assuming that an interlocutory order or decree grants or continues an injunction, the complainant, according to the contention of the petitioners, would have a right of appeal if the defendant appealed, but would have no right of appeal if the defendant did not appeal. The complainant would be as much aggrieved in the one case as in the other, and yet in one case it would have the right of appeal, and in the other it would not. If the law had provided in terms that the complainant should have a right of appeal *by and with the consent of defendant*, or upon the *defendant's written stipulation* to that effect, it plainly would be absurd upon its face, yet the act, if construed as petitioners contend, would be the same as if such ridiculous clauses were read into it.

Again, if an interlocutory decree in a patent suit, for example, should grant an accounting under all the claims, but should, for some reason, deny an injunction, the complainant would have no right of appeal. If, however, the decree granted still further relief to the complainant in the form of an injunction, and the defendant appealed, the complainant would have the right of appeal. In other words, when the complainant gets less relief from the Court it has no right of appeal, but when it gets more relief it has the right of appeal. Such a system would be illogical and contrary to common sense and justice. It is a rule of statutory construction that absurdity will be avoided if possible.

In *United States vs. Kirby*, 7 Wall., 482, this Court said:

> "All laws should receive a sensible construction. General terms should be so limited in their application as not to lead to injustice, oppression or an absurd consequence."

In *State vs. Clark*, 5 Dutcher, 96, 99, the Supreme Court of New Jersey said:

> "If a literal construction of the words of a statute be absurd, the act must be construed so as to avoid the absurdity. The Court must restrain the words. The object designed to be reached by the act must limit and control the literal import of the terms and phrases employed. 1 *Kent's Com.*, 462; *Commonwealth vs. Kimball*, 24 Pick., 370; *United States vs. Fisher*, 2 Cranch, 400; 1 Bl. Com., 60."

Sutherland on Statutory Construction (2nd ed.) Section 347, states the law as follows:

> "In determining the scope of general provisions there is a leaning to prevent absurdity, for it cannot be deemed intended; also injustice for like reason."

4. The fundamental principle of statutory construction to which all others are subordinate is that the intent of the Legislature must control even where it is against the literal meaning of the statute.

From the facts and circumstances to which we have previously referred, it follows unmistakably that whatever ambiguity, if any, there may be in section 7, it was the intention of Congress to give relief by that section to a defendant and only to a defendant, and only in a case where the defendant was suffering from an injunction. There is no single fact evidencing any intent on the part of Congress to extend relief under this section to a complainant. The only argument that can be made in support of the petitioners' contention is that of convenience. But where the intent of the legislature is clear, the question of convenience is not to be considered; the intent must control.

In *Hawaii vs. Mankichi*, 190 U. S., 212, this Court said:

> "The books are full of authorities to the effect that the intention of the law-making power will prevail, even against the letter of the statute," &c.

In the *Eureka* case, 4 Sawyer, 302, 317, Mr. Justice FIELD said:

> "Instances without number exist where the meaning of words in a statute has been enlarged or restricted and qualified to carry out the intention of the legislature. The inquiry where any uncertainty exists, always is as to what the legislature intended, and when that is ascertained, it controls."

Sutherland on Statutory Construction (2d ed.), Section 364, states the rule as follows:

> "It is the intent of the law that is to be ascertained and the courts do not substitute their views of what is just or convenient."

VI.

The decree herein was interlocutory, not final, within the meaning of the judiciary act as interpreted by this Court.

One of the positions of the petitioners is that the decree is in fact a final decree, and, therefore, appealable as such; or that, if not classifiable as a final decree, then, at least, it is of the exceptional class of interlocutory decree, held to be appealable in the case of *Forgay vs. Conrad*, 6 How., 201.

The decisions of this Court differentiating interlocutory and final decrees have been so numerous and have so clearly crystallized the distinction between interlocutory and final decrees that at this day there should be no reasonable ground for any confusion; and this Court has so frequently emphasized the limitations of the doctrine applied in *Forgay vs. Conrad, supra*, that the scope of that decision is absolutely clear.

That a decree in a patent case awarding a perpetual injunction and an accounting is interlocutory only, because something *within the pleadings* yet remains to be *judicially* determined, has been expressly determined again and again.

Barnard vs. Gibson, 7 How., 650.
Smith vs. Vulcan Iron Works, 165 U. S., 518.

The whole subject is thoroughly discussed in the opinion of Mr. Justice Brown in *McGourkey vs. Toledo R. R. Co.*, 146 U. S., 536, where numerous earlier decisions are collated. From the decision it is made clear that in order to be a final decree, there must be no matter of controversy *within the pleadings* in the case to be *judicially* determined after the entry of the decree. A final decree disposes of every issue between the parties raised by the pleadings, leaving nothing to be done, except such *ministerial* action as may be ne-

cessary to put such decree into execution. If, said Mr. Justice Brown, the decree "refer the case to a master * * * as a subordinate court and for a judicial purpose, as to state an account between the parties, upon which a further decree is to be entered, the decree is not final." This is the precise situation here. It is conclusive of the broad question and is not affected by the fact that the decree finds against the complainant on some of the issues involved.

And it has been expressly decided that though a decree order an absolute judgment with costs in favor of a plaintiff in error on certain of the issues raised by the pleadings, leaving nothing to be judicially determined as to such issues, yet the judgment is not final, because *other issues within the pleadings remain to be determined*, and, therefore, no appeal will lie.

Holcombe vs. McKusick, 20 How., 552.

And in a patent suit it has been held that even though the decree *dismissed the bill of complaint as against one of several defendants* charged with joint infringement, yet the decree was not final, and, therefore, not appealable.

Hohorst vs. Hamburg Amer. Packet Co., 148 U. S., 262.

As was said by Judge Putnam in *Marden vs. Campbell*, 67 Fed. Rep., 809, 813, where the exact argument made by these petitioners was overruled:

> "It would be contrary to all well conceived notions to imagine two final decrees in a patent cause of this character."

Moreover, precisely such a decree as the one at bar, and in a patent case, has been specifically stated by this Court to be interlocutory. In *Estey vs. Burdett*, 109 U. S., 633, the Court said,

> "The circuit court *made an interlocutory decree* declaring the patent to be valid so far as claims 1 and 2 are concerned; that those two claims had been infringed; that the plaintiff was not the

original and first inventor of what is set forth in claim 4 and did not, before the commencement of this suit, file a disclaimer of what is claimed in claim 4 and had not unreasonably neglected to file such disclaimer, and had presented evidence of his having filed such disclaimer; that no evidence had been offered to show any infringement of claim 3 and that the plaintiff was entitled to recover profits and damages because of such infringement. A reference to a master to ascertain the same was ordered, and a perpetual injunction was awarded as to claims 1 and 2. On the report of the master a *final decree* was made for the plaintiff, for $161,011.79, without costs to either party. The decisions of the circuit court in the case are reported in 15 Blatchf. (C. C.), 349, 16 *Id.*, 105, and 19 Id., 1. The defendants have appealed."

The decision of the Circuit Court (5 Bann. & Ard., 7) shows that claim 4 was at issue and that the bill was dismissed as to it.

Again, in *Yale Lock Mfg. Co. vs. Berkshire Bank*, 135 U. S., 342, where one patent had been held invalid and another valid and infringed, the Court referred to the decree as an interlocutory decree and to the decree entered after the accounting on the valid patent, as a final decree. Both parties appealed from the latter. The petitioners herein admit that there can be but one decree that they can appeal from as final, and urge that if they are right in considering the present decree a final one, they will, under the authority of *Hill vs. Chicago R. R.*, 140 U. S., 52, be unable to appeal from the (real) final decree to be hereinafter entered, because such decree will necessarily be entered more than six months after the entry of the present decree. But in the Yale Lock case the complainant appealed from the (real) final decree, and his appeal was accepted; it apparently did not occur to Court or counsel in the case that there was any question as to which

decree was final and appealable, and which merely interlocutory.

Exactly the same situation was also present in *Bussey vs. Excelsior Mfg. Co.*, 110 U. S., 131, where three patents were involved. The lower Court dismissed the bill as to one patent, and held the other two valid and infringed. After an accounting, the final decree was entered, and both parties appealed from the latter decree.

It is thus the settled practice of this Court to consider a decree in a patent suit, that dismisses the bill as to part of the issues and orders an injunction and an accounting as to others, as interlocutory and not as one that can be appealed from as a final decree.

It is, therefore, clear that there is no ground for the petitioners' contention that, because the decree definitely decided the issues as to some of the claims of the patent, it thereby becomes a final decree.

But the petitioners, as we understand their argument, contend that, granting the decree to be interlocutory, yet it is of the class that falls within the doctrines of *Forgay vs. Conrad*, 6 How, 201, and *Hill vs. Chicago & Evanstown R. R. Co.*, 140 U. S., 52, and, therefore, may be appealed from by complainants, independently of the provisions of Sec. 7 of the Judiciary Act as amended in 1900.

In *Forgay vs. Conrad* the decree directed the delivery to complainant of certain lands and slaves and a sum of money, and provided that the complainant have execution therefor. Mr. Chief Justice TANEY in this case took care to point out that if the decree below had, as it should, refrained from ordering an actual delivery of the property, with execution therefor, an appeal would have awaited the coming in of the master's report.

Forgay vs. Conrad has frequently been misinterpreted by eager appellants. Thus in *Beebe vs. Russel*, 19 How., 283, the Court said:

> "It has been supposed that this court did not apply its present interpretation of the laws regu-

lating appeal in the cases of *Whiting v. Bank of the United States*, 13 Pet., 6; of *Michaud vs. Girod*, 4 How., 503, and in *Forgay et al v. Conrad*, in 6 How., 201.

* * * * * *

"In *Forgay's* case, it was made upon the decree given by the court below, and it was adjudged by this court to be final, to give this court jurisdiction of it. But it was so, upon the ground that the whole merits of the controversy between the parties had been determined, that execution had been awarded, and that the case had been referred to the Master merely for the purpose of adjusting the accounts. The fact is, the order of the court in that case for referring it to a master was peculiar, making it doubtful, if it could in any way control or qualify the antecedent decree of the court upon the whole merits of the controversy, or modify it in any way, except upon a petition for a rehearing."

See also, as definitive of *Forgay vs. Conrad*, and as indicating the various essentials of a final decree, or one appealable as such under the doctrine of that case:

Barnard vs. Gibson, 7 How., 650.
Craighead vs. Wilson, 18 How., 199.
Burlington Ry. Co. vs. Simmons, 123 U. S., 52.
McGourkey vs. Toledo Co., 146 U. S., 536.
Louisiana Bank vs. Whitney, 121 U. S., 284.
Covington vs. National Bank, 185 U. S., 270.

Moreover, the cases of *Estey vs. Burdett*, *Yale Lock Mfg. Co. vs. Berkshire Bank* and *Bussey vs. Excelsior*, referred to above, are amply sufficient to show that this Court has considered that interlocutory decrees in patent cases, dismissing the bill as to some of the issues, are not within the exception of the Forgay case.

It is said by the petitioners that this case is like the case of *Scriven vs. North*, 134 Fed. Rep., 366, in the

Fourth Circuit, where it was held that an appeal by complainant would lie under the doctrine of *Forgay vs. Conrad*. But the decree in this case is wholly unlike the decree in the Scriven case, and is not within the principles there announced. Moreover, the reasoning in the Scriven case, even as applied to the facts of that case, is at variance with *Forgay vs. Conrad*, upon which the Court based its decision.

The Scriven case included four distinct and "separate causes of action"—(1) patent infringement, (2) trade-mark infringement, (3) unfair copying of goods, (4) unfair dressing of goods. As to all but the fourth of these, the decree dismissed the bill. The Court held that the decree was so exceptional that it could be considered final, citing the Forgay case. There is no such decree in the present case. A single patent is involved and the complainant has merely been refused as broad relief under its patent as it asked. It is an ordinary interlocutory decree in a patent cause.

But even as relating to the exceptional decree in the Scriven case, the Court, we submit, misapplied the ruling of this Court in the Forgay case, because the decree did not order any delivery of property or award execution. The complainant suffered only that delay which must in every case be suffered by a party who must await the entry of a final decree before appealing.

The suggestion by the petitioners that the holding in the decree that some of the claims of the Claus patent are invalid "divests complainants of their property" is absurd. The decree only postpones, if these claims are valid, the enforcement of complainants' rights thereunder.

The petitioners have misleadingly cited the case of *Hills vs. Chicago R. R. Co.*, 140 U. S., 52, so quoting it as to make it seem in direct conflict with the decisions cited herein. In the Hill case the bill was dismissed *in toto* as against many of the defendants, and against the others there was but a *single severable item* left to be determined by the master. Such a decree was "an

exception created by the peculiar circumstances of" the case.

National Bank vs. Smith, 156 U. S., 330, 335.

Its holding was not even broad enough to include a case where the bill was dismissed as to certain of alleged joint infringers, but not as to the others.

Hohorst vs. Packet Co., 148 U. S., 262, 266.

It is submitted that the decree herein is not of such character as to fall within any of the exceptions announced by this Court to the general rule

> " that a decree to be final for the purposes of an appeal must leave the case in such a condition that if there be an affirmance here, the Court below will have nothing to do but to execute the decree it has already entered."

Dainese vs. Kendall, 119 U. S., 53, 55.

National Bank vs. Smith, supra.

Wirthrop Iron Co. vs. Mackey, 109 U. S., 180.
Keystone Iron Co. vs. Martin, 132 U. S., 91,
and authorities there cited.

VII.

The petition should be denied.

New York, February 19, 1906.

Respectfully submitted,

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WALTER F. ROGERS,
JACOB STEINHARDT,
Of Counsel for New England Enameling Company.

Supreme Court of the United States.

No. 17, Original.—October Term, 1905.

Ex parte National Enameling and Stamping Company and Lalance & Grosjean Manufacturing Company, Petitioners. } Petition for Writ of Mandamus.

[March 19, 1906.]

In March, 1903, the petitioners filed their bill in the Circuit Court of the United States for the Southern District of New York against the New England Enameling Company, to restrain the further infringement by that company of letters patent of the United States, No. 527,361, for improvements in enameling metal ware, and to recover damages for past infringement. After answer and proofs the case came on for hearing, and on July 8, 1905, a decree was entered, reciting that nine of the twelve claims in the patent were good and valid, that three were invalid and void by reason of the fact that the patentee was not the original or first inventor or discoverer, that five of the nine valid claims had been infringed by the defendant, but the remaining four had not been. As to the claims held invalid and those found to have been not infringed, it was ordered that the bill of complaint be dismissed. As to the remaining five claims, those held to be infringed, it was ordered that the plaintiffs recover the gains, profits, savings and advantages which the defendant had derived by reason of the infringement, and that the case be referred to a master to report the amount thereof, and also that an injunction issue against further infringement. On August 1, 1905, the defendant appealed from said decree to the Court of Appeals and filed its assignment of errors. On August 8 the plaintiffs also appealed to the Circuit Court of Appeals and assigned as errors the rulings in the decree adverse to them. On January 3, 1906, this cross appeal of the plaintiffs was dismissed by the Court of Appeals, on the ground that it had no jurisdiction thereof. Thereupon the plaintiffs filed in this court this petition for a writ of mandamus commanding the judges of the Circuit Court of Appeals to take jurisdiction of said cross appeal, and to dispose of it simultaneously with the appeal of the defendant.

Mr. Justice Brewer delivered the opinion of the Court.

The decree entered by the Circuit Court was interlocutory and not final. *Barnard* v. *Gibson*, 7 How. 650; *Humiston* v. *Stainthorp*, 2 Wall. 106,

and cases cited in note; *Estey* v. *Burdett*, 109 U. S. 633, 637; *McGourkey* v. *Toledo & Ohio Railway Company*, 146 U. S. 536 (in this case is a full discussion of the differences between an interlocutory and a final decree;) *Hohorst* v. *Hamburg-American Packet Company*, 148 U. S. 262; *Smith* v. *Vulcan Iron Works*, 165 U. S. 518.

Plaintiffs brought one suit upon a single patent. The findings of the Circuit Court that three of the twelve claims were invalid and that the remaining nine were valid, but that four of them had not been infringed by the defendant, did not break this one suit into twelve. They were a guide to the master in his ascertainment of the damages and indicated the scope of the final decree.

In the Federal courts no appeal can, as a general rule, be taken, except from a final decree. As said by Mr. Chief Justice Taney in *Forgay* v. *Conrad*, 6 How. 201, 205:

"In this respect the practice of the United States chancery courts differs from the English practice. For appeals to the House of Lords may be taken from an interlocutory order of the Chancellor, which decides a right of property in dispute. . . . But the case is otherwise in the courts of the United States, where the right of appeal is by law limited to final decrees." See also *McLish* v. *Roff*, 141 U. S. 661, 665.

In the latter case this was held persuasive against extending the right of review given by section 5 of the Circuit Court of Appeals act of March 3, 1891, (26 U. S. Stat. 826,) to other cases than those in which there was a final judgment or decree, although the word "final" is omitted in some of the clauses of the section.

By section 7 of that act, however, an appeal was provided from certain interlocutory orders or decrees. That section has been twice amended. (28 U. S. Stat. 666; 31 U. S. Stat. 660.) As it now stands it reads:

"SEC. 7. That where, upon a hearing in equity in a District Court or in a Circuit Court, or by a judge thereof in vacation, an injunction shall be granted or continued or a receiver appointed, by an interlocutory order or decree, in a cause in which an appeal from a final decree may be taken under the provisions of this act to the Circuit Court of Appeals, an appeal may be taken from such interlocutory order or decree granting or continuing such injunction or appointing such receiver to the Circuit Court of Appeals: *Provided*, That the appeal must be taken within thirty days from the entry of such order or decree, and it shall take precedence in the appellate court; and the proceedings in other respects in the court below shall not be stayed, unless otherwise ordered by that court, or by the appellate court or a judge thereof, during the pendency of such appeal: *Provided, further*, That the court below may in its discretion require as a condition of the appeal an additional bond."

It will be noticed that the appeal is allowed from an interlocutory order or decree granting or continuing an injunction, that it must be taken within thirty days, that it is given precedence in the appellate court,

that the other proceedings in the lower court are not to be stayed, and that the lower court may require an additional bond. Obviously that which is contemplated is a review of the interlocutory order, and of that only. It was not intended that the cause as a whole should be transferred to the appellate court prior to the final decree. The case, except for the hearing on the appeal from the interlocutory order, is to proceed in the lower court as though no such appeal had been taken, unless otherwise specially ordered. It may be true, as alleged by petitioners, that "it is of the utmost importance to all of the parties in said cause that there shall be the speediest possible adjudication by the United States Circuit Court of Appeals as to the validity of all of the claims of the aforesaid letters patent which are the subject matter thereof." But it was not intended by this section to give to patent or other cases in which interlocutory decrees or orders were made any precedence. It is generally true that it is of importance to litigants that their cases be disposed of promptly, but other cases have the same right to early hearing. And the purpose of Congress in this legislation was that there be an immediate review of the interlocutory proceedings and not an advancement generally over other litigation.

Petitioners rely mainly on *Smith* v. *Vulcan Iron Works*, 165 U. S. 518. In that case it was held that when an appeal is taken from an interlocutory order granting or continuing an injunction, the whole of the order is taken up, and the appellate court may (if upon an examination of the record as thus presented it is satisfied that the bill is entirely destitute of equity) direct a dismissal, and is not limited to a mere reversal of the order granting or continuing the injunction. Take an ordinary patent case. If an injunction is granted by an interlocutory order and the order is taken on appeal to the Circuit Court of Appeals, and that court is of opinion that the patent is on its face absolutely void, it would be a waste of time and an unnecessary continuance of litigation to simply enter an order setting aside the injunction and remanding the case for further proceedings. The direct and obvious way is to order a dismissal of the case, and thus end the litigation. And such is the scope of the opinion in that case. After noticing the general rule that appeals will not lie until after final decree, and that an order or decree in a patent case granting an injunction and sending the cause to a master for accounting is interlocutory only, and therefore not reviewable on appeal before the final decree in the case, it referred to the provision of section 7, and said (p. 525):

"The manifest intent of this provision, read in the light of the previous practice in the courts of the United States, contrasted with the practice in courts of equity of the highest authority elsewhere, appears to this court to have been, not only to permit the defendant to obtain immediate relief from an injunction, the continuance of which throughout the

progress of the cause might seriously affect his interests; but also to save both parties from the expense of further litigation, should the appellate court be of opinion that the plaintiff was not entitled to an injunction because his bill had no equity to support it."

But nowhere in the opinion is it intimated that the plaintiff was entitled to take any cross appeal or to obtain a final decree in the appellate court. This view of the scope of section 7 was reaffirmed in *Mast, Foos & Co.* v. *Stover Manufacturing Company*, 177 U. S. 485, 494, 495.

It is suggested that, as to the claims held to be invalid and those held to be valid but not infringed, the bill was dismissed; that thus, in fact, a final decree was entered which entitled the plaintiff to an appeal. *Forgay* v. *Conrad*, *supra*, and *Hill* v. *Chicago & Evanston Railroad Company*, 140 U. S. 52, are cited as authorities. In both these cases there were several defendants and the decrees were adjudged final only in respect to certain of the defendants. In the first the Circuit Court passed a decree declaring sundry deeds to be fraudulent and void and directing the lands and slaves therein mentioned to be delivered up to the complainant, and also directing one of the defendants named in the decree to pay him $11,000, and "that the complainant do have execution for the several matters aforesaid in conformity with law and the practice described by the Supreme Court of the United States." The court refused to dismiss the appeal, holding that, while the decree was not final in the strict technical sense of the term, yet in view of the effect of the orders entered and the fact that unless review was granted at once there might be irreparable injury, the decree must be regarded as final to that extent. At the same time it criticised the terms of the decree, said that the final orders should have been delayed until the master's report was received, and added, after its comments upon the procedure below, (p. 206):

"These remarks are not made for the purpose of censuring the learned judge by whom this decree was pronounced, but in order to call the attention of the Circuit Courts to an inconvenient practice into which some of them have sometimes fallen, and which is regarded by this court as altogether inconsistent with the objects and policy of the acts of Congress in relation to appeals, and at the same time needlessly burdensome and expensive to the parties concerned, and calculated, by successive appeals, to produce great and unreasonable delays in suits in chancery. For it may well happen that, when the accounts are taken and reported by the master, this case may again come here upon exceptions to his report, allowed or disallowed by the Circuit Court, and thus two appeals made necessary, when the matters in dispute could more conveniently and speedily, and with less expense have been decided in one."

In the subsequent case of *Beebe* v. *Russell*, 19 How. 283, in which the rule in reference to the finality of decrees was further considered, it was said, in explanation of the decision in the *Forgay case*, (p. 287):

"In *Forgay's case*, it [the question] was made upon the decree given by the court below, and it was adjudged by this court to be final to give this court jurisdiction of it. But it was so, upon the ground that the whole merits of the controversy between the parties had been determined, *that execution had been awarded*, and that the case had been referred to the master merely for the purpose of adjusting the accounts. The fact is, *the order of the court in that case for referring it to a master was peculiar*, making it doubtful, if it could in any way control or qualify the antecedent decree of the court upon the whole merits of the controversy, or modify it in any way, *except upon a petition for a rehearing*."

In *Hill* v. *Chicago & Evanston Railroad Company*, *supra*, there had been an order of dismissal in favor of some of defendants, together with a reference to a master of a separable controversy between the plaintiff and other parties, and the court observed (p. 54):

"But there was no adjudication as to the payment of the amount to be ascertained by the master; that remained unsettled. It was, however, a severable matter from the other subjects of controversy and did not affect their determination. The fact that it was not disposed of did not change the finality of the decree as to the defendants against whom the bill was dismissed; that amount, or to whom made payable, did not concern them. They were no longer parties to the suit for any purpose. The appeal from the subsequent decree did not reinstate them. All the merits of the controversy pending between them and the complainant were disposed of, and could not be again reopened, except on appeal from that decree. As to the other parties, it remained to ascertain the amount of one item and to determine as to its payment."

But as held in *Hohorst* v. *Hamburg-American Packet Company*, *supra*, that rule does not apply to cases where the liability of the defendant is alleged to be joint; and, therefore, cannot to a case in which there is but a single defendant.

The rule is discharged, and the application for a writ of mandamus is denied.

No. 18, Original.

Ex parte Automatic Switch Company of Baltimore City, Petitioner. } Petition for Writ of Mandamus.

[March 19, 1906.]

Mr. Justice BREWER delivered the opinion of the Court.

This case, though differing in its facts somewhat from the one immediately preceding, presents the same question, and the same order will be entered.